

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue Application of:

BORDEN M. LARSON, ET AL.

Reissue of: U.S. Patent No. 5,979,350)

Reissue Appln. No.: 09/613,154)

Filed: June 30, 2000)

For: WATER SPORT TOWING)
APPARATUS AND METHOD)

Examiner:

Mr. Stephen Avila

Group Art Unit: 3612

Current Status: Pending

REISSUE LITIGATION

Box REISSUE
Commissioner for Patents
Washington, D.C. 20231

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APPLICANT'S REPLY TO PROTEST

Applicant Correct Craft, Inc. submits the following reply and the evidence gathered in the accompanying Appendix in response to the December 2, 2000 Protest submitted on behalf of MasterCraft Boat Company by its attorney.

I. CORRECTION OF INVENTORSHIP

In the reissue application, Correct Craft requests correction of inventorship to add Robert Todd as a co-inventor. Nothing in the Protest in any way suggests that Mr. Todd is not correctly named as a co-inventor, and therefore Correct Craft respectfully submits that correction of inventorship is appropriate.

II. THE DESIGN APPLICATION PROVIDES SUFFICIENT DISCLOSURE FOR CLAIMS MADE IN THE UTILITY APPLICATION

At pages 9-11 of the Protest, MasterCraft cites a 1985 Federal Circuit opinion¹ and an earlier 1981 CCPA opinion² for the proposition that the disclosure in Design Patent 409,972 (the '972 patent) does not support any of the claims made in U.S. Patent 5,979,350 (the '350 patent). However, MasterCraft does not cite the most recent decision of the Federal Circuit which supports Correct Craft's position, and MasterCraft also fails to carefully analyze the specific details of the apparatus claims (for example, Claims 33-36) of the '350 patent, which read on the drawings of the '972 patent. Correct Craft submits that after considering an analysis of the applicable law and the relationship of the drawing of the '972 patent as set out below, the Examiner will conclude that claims in the '350 patent are indeed supported by the disclosure in the '972 patent.

A. The Applicable Law

In Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 19 U.S.P.Q. 2d 1111 (Fed.Cir. 1991), the Court was presented with the issue of whether an earlier design patent for a "Double Lumen Catheter" contained a disclosure which met the requirements of 35 U.S.C. §112 for purposes of a subsequent continuing utility application. In

¹KangaRoos U.S.A., Inc. v. Caldor, Inc., 778 F.2d 1571, 1574, 228 U.S.P.Q. 32, 33-34 (Fed.Cir. 1985).

²In re Berkman, 642 F.2d 427, 430, 209 U.S.P.Q. 45, 47 (CCPA 1981).

reversing the District Court's finding that the drawings of the design patent did not adequately support the utility application, the Federal Circuit held that:

...(U)nder proper circumstances, drawings alone may provide a "written description" of an invention as required by §112. Whether the drawings are those of a design application or a utility application is not determinative, although in most cases the latter are much more detailed. In the instant case, however, the design drawings are substantially identical to the utility application drawings.

* * * * *

We find the District Court's concern with "what the invention is" misplaced, and its requirement that the (design) drawings "describe what is novel or important" legal error... . "The invention" is defined by the claims on appeal. The instant claims do not recite *only* a pair of semi-circular lumens, or a conical tip, or a ratio at which the tip tapers, or the shape, size, and placement of the inlets and outlets; they claim a *double lumen catheter* having a *combination* of those features. That combination invention is what the (design) drawings show.³

The utility claims that were at issue in Vas-Cath are set out as an Appendix to the decision at 19 U.S.P.Q. 2d 1120; it should be noted that the claims in question are extremely specific with respect to the catheter in question. Nevertheless, the Court found that these specific limitations were still sufficiently disclosed in the original design application drawings.

³935 F.2d at 1561; 19 U.S.P.Q. at 1118 (emphasis in original).

Correct Craft submits that MasterCraft, in the analysis at page 10 of the Protest, is making the same mistake that was rejected by the Federal Circuit in Vas-Cath; namely, MasterCraft attempts to characterize what is "the invention" rather than look to the specific claim elements in the '350 patent. As is set out next, an analysis of the claims in the '350 patent clearly demonstrate that the specific elements of the apparatus claims are fully supported by the drawings in the parent design application.

B. A Comparison of the '350 Claims With the Drawing of the Parent Design Patent

As a preliminary matter, Correct Craft points to the fact that the tower structure shown in Figures 1, 2, 6 and 10 of the '350 patent is identical to the boat tower construction shown in Figures 1-7 of the '972 design patent; this identity is accurate down to the angular relationship of the two arching members, the number of the horizontally extending bars on both sides of the tower, the number and spacing of the horizontally extending bars between the horizontal bridging members of each arch and the location of the tow rope attachment means. Further, the description of the drawing in the '972 patent makes it clear that the attachment points are at the bottom of each vertical leg and that the tow rope attaching means is part of an upper horizontal element.

Using apparatus Claims 33-36 as an example, the following comparison chart is prepared to assist the Examiner in understanding how there is direct identity between the construction

shown in the design patent and that which is recited in these claims:

33. A towing apparatus for a performer using a water sport implement and being towed behind a vessel while maintaining the stability of the vessel, the vessel having a bow, a stern, opposing sides extending from the bow to the stern, and an operator station located amidships between the opposing sides, the towing apparatus comprising:

a first relatively rigid U-shaped support structure A for fitting to the sides across the beam of the vessel at a point forward of the operator station and positioned amidships substantially above the level of the operator station;

a second relatively rigid U-shaped support structure B for fitting to the sides across the beam of the vessel and positioned amidships substantially above the level of the operator station;

a plurality of bars C,D,E,F,G,H,I extending between the U-shaped support structures A,B so that the first and second U-shaped support structures A,B in combination with the plurality of bars C-I from a skeletal frame, and wherein the first U-shaped support structure A is positioned forward of the second U-shaped support structure B; and

tow rope attaching means J fitted to the upper portion of the skeletal frame for attaching a tow rope thereto.

34. The apparatus according to claim 33 further comprising attaching means K for attaching the skeletal frame to the vessel, so as to permit the skeletal frame to be rotated downwardly onto a deck portion of the vessel.

35. The apparatus according to claim 33, wherein the longitudinally extending bars G-I are generally parallel to the floor of the vessel.

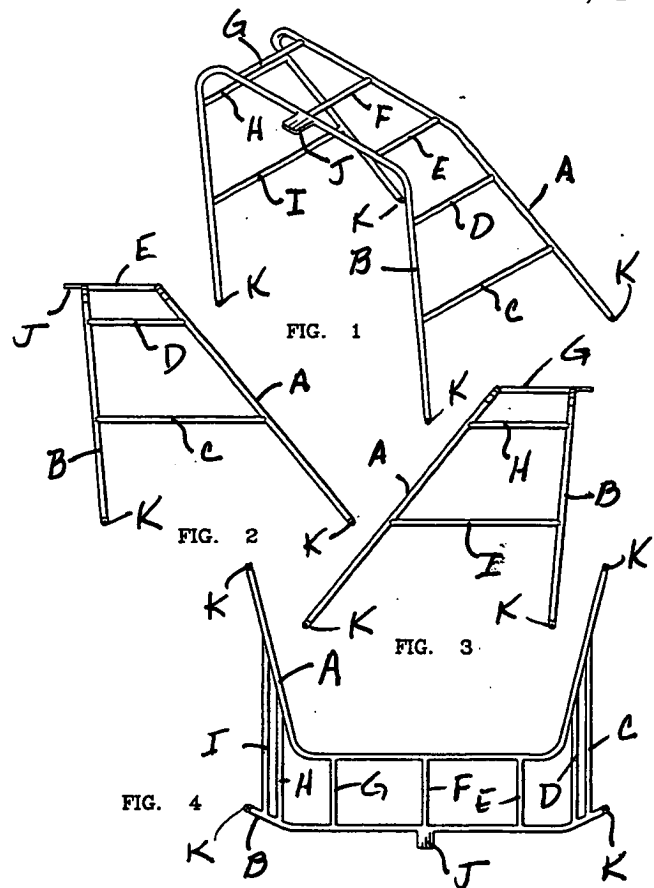
36. The apparatus according to claim 33, wherein the tow rope attaching means J comprises a tow rope connecting element fixedly attached to the upper extremity of the skeletal frame.

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Accordingly, Correct Craft respectfully submits that it is entitled to claim priority from the earlier, co-pending design application.

III. CORRECT CRAFT'S EVIDENCE SUBMITTED IN OPPOSITION TO PROTEST

Correct Craft submits the evidence set out in the accompanying Appendix in opposition to the evidence submitted with the Protest. The following is a discussion of that evidence, with reference to the tab number where the evidence appears in the Appendix. The manner in which this evidence overcomes the submission in the Protest is described in greater detail in Section IV below.

The 1998 *WaterSki* magazine tests (Tab 1). In its January/February 1998 issue, *WaterSki* magazine reported extensive tests on 84 recreational towboats, including a Correct Craft boat having the new towing tower which is the subject of the '350 patent. A copy of that report at pages 89 and 90 is reproduced at Tab 1. This article makes no reference to anyone at the magazine having earlier witnessed the alleged events described in the King declaration.

The January/February 2001 issue of *BoatingLife* magazine (Tab 2). *BoatingLife* magazine is also published by World Publications, Inc. At page 23 of this issue, there is a report about the first impressions of the test team from *WaterSki* magazine three years previously (i.e., the 1998 tests referenced in the 1998 issue of *WaterSki* magazine in Tab 1 above). The entire *BoatingLife* article is reproduced on the following page:

Tower Power

HOW TO ADD FUN — AND ROOM — TO YOUR BOAT

At first, it looks about as practical as fixing a parrot cage to the top of the family sedan. The metal bars look like they'll implode. Someone is bound to wind up with a welt on the noggin, you think. Besides, you just aren't supposed to secure a jungle gym to top of a boat.

Those were the same thoughts that ran through the minds of the test team at the *WaterSki* magazine boat tests three years ago when Correct Craft unveiled one of the best inboards in the business ... with a funky tower attached to the topside.

"We made jokes about it," says Correct Craft president Walt Meloan, remembering his reaction at seeing the first Air Nautique roll out of his production facility. "We never thought the market would be where it is today."

Every ski-boat maker in the business has grabbed onto the tower concept. Most of them say this year they'll sell more boats with towers than without. Stern-drive owners are now putting after-market towers on their boats. So, what's the attraction?

Look again. The sporty image will eventually grow on you. So will the sounds of tunes coming from speakers attached

overhead. And yes, it's nice to take skis and boards off the floor and store them in what is essentially attic space. But the primary reason for towers was — and still is — to make water-sports more fun, more exciting and just plain easier.

With the rope attachment seven feet above the floor of the boat, skiers and riders get a virtual lift from above. Think of it this way: Sit on the living room floor facing your spouse and try to pull him or her up. You'll struggle. Stand up and pull your spouse to his or her feet — no problem.

So, what started as a tool to tap into the growing popularity of wakeboarding has played right into the hands of skiers, boarders and tubers. And they're reaping benefits behind every type of runabout.

"We've put them on everything, even fish-and-skis," says Rene Swor, vice president of sales for Big Air Pylons. "People find that towers open up the boat so you can take more friends."

Who would have thought boaters could have more fun, more style and more room, all because of a giant bird cage?
— Robert Stephens

Together with the article at Tab 1, this article is submitted to address this most serious question: if representatives of *WaterSki* magazine were present at the events described in the King declaration⁴, why is it that the test team from *WaterSki* magazine was so startled by the appearance of the Correct Craft towing tower at the time of the later tests in 1998?

The affidavit of Ms. Shelley Hotz (Tab 3). Ms. Hotz is a paralegal in the law firm of undersigned counsel (Tab 3, ¶1). In response to a request, she conducted an on-line search of the records of the Florida Department of Transportation and Safety with respect to the registration of the boat bearing Florida hull registration No. FL9976CP (i.e., the hull number shown in the photograph attached to the King declaration) (Tab 3, ¶2). After conducting that search, Ms. Hotz obtained a printout from the records of the Florida Department of Transportation and Safety indicating that the boat bearing Florida hull registration No. FL9976CP was titled in the name of Tom King Inc., and that the registration was issued on April 19, 1996 (Tab 3, ¶3). Thereafter, Ms. Hotz contacted a search service in Tallahassee, Florida and obtained a further title report from that search service confirming the results of Ms. Hotz' earlier investigation (Tab 3, ¶4). The printout obtained by Ms. Hotz is appended as Exhibit B to her affidavit, and the report obtained from the search service in

⁴The King declaration is set out at Exhibit 5 in the Protest.

Tallahassee is appended as Exhibit C. Ms. Hotz then obtained a certified copy of the title report, Exhibit D (Tab 3, ¶4). The results of Ms. Hotz' investigation raises a serious question as to the accuracy of the dates contained in the King declaration, since it appears that the declarant only recorded title to the boat in 1996.

Affidavit of Carl M. Napolitano (Tab 4). Dr. Napolitano is a registered patent agent with the undersigned's law firm. As a part of a review of the Protest, he was asked to determine the vintage of the Mercury Marine outboard motor shown in the color photograph which forms a part of the King declaration. As part of that investigation, on Wednesday, February 14, 2001, Dr. Napolitano visited a retail boat dealer located in Orlando, Florida and met with the owner, Mr. Jeff Hood, and his staff (Tab 4, ¶¶1 and 2). From that investigation, Dr. Napolitano learned that the Mercury Marine motor shown in the photograph attached to the King declaration is most likely a 1997 model of a Mercury offshore motor having a V-6 engine and which is rated at 200 hp (Tab 4, ¶4). Since it establishes that the Mercury outboard motor on the boat shown in the photograph is most probably a 1997 model, this affidavit raises a question as to when the photograph attached to Mr. King's declaration was taken.

Affidavit of Robert Todd (Tab 5). Mr. Todd is 39 years of age and is a master welder with twenty years experience; since 1992, he has been a welder in the marine industry and since 1994 has done business as Todd's T-Tops & Towers in Winter Park, Florida. His

company specializes in the construction of a wide variety of radar arches, tuna towers, outriggers and other hardware for boats of all sizes (Tab 5, ¶2).

In the Fall of 1996, Mr. Todd was asked by Correct Craft, Inc. to participate in the design of a towing tower to be mounted over the operator station of Correct Craft's **NAUTIQUE** recreational towboats. After conducting an analysis of the number and location of welds which might affect the strength of a towing tower, Mr. Todd reports that the inventors decided to use a tower construction that employs a pair of arches defining four legs, with two of the legs mounted on opposite gunwales of the boat forward of the windshield of the boat, and two legs also mounted on the opposite gunwales aft of or adjacent to the windshield. This construction was also designed with longitudinally extending horizontal bars welded at attachment points fore and aft to the respective arches, and with a tow rope connecting element fixed directly to the aft, generally horizontal portion of the construction. Mr. Todd notes that this last feature was very important because the horizontal stresses of a towed athlete can be more easily transmitted across a horizontal bridging portion than to a vertically-extending element. He notes that this construction was selected as the original prototype and is depicted in Figures 1-7 of the '972 patent, and Figures 1, 2 and 6-8 of the '350 patent (Tab 5, ¶4).

With respect to the King declaration, Mr. Todd sets out at ¶6 of his affidavit a detailed analysis of the deficiencies of the tow rope attaching technique allegedly used by Mr. King. Specifically,

Mr. Todd notes that the tower structure shown in the King photograph is not designed for towing individuals, and that if a person were to attach the tow rope as shown in this photograph, it is likely that after a short period of time the tow rope would tear away from the point of attachment. In support of that analysis, Mr. Todd attaches as Exhibit D to his affidavit an enlarged copy of the King photograph, which more clearly shows the small, vertically-extending flat plate which is welded at the top to a platform and at the bottom to a truss. Mr. Todd notes that the truss in the King photograph is not attached to the gunwales of the boat, but is instead welded to opposing stanchions (Tab 5, ¶6). From this analysis, Mr. Todd concludes that it is unlikely that Mr. King conducted any significant level of use of his tower for towing purposes. Mr. Todd's opinion in that regard is bolstered by the fact that he has been closely attuned to tower developments in the marine industry in Florida for the last fifteen years, and had not previously seen a tower used in the manner allegedly used by Mr. King. He also notes that given the difficulties that wakeboarders have experienced over the years with extended pylons, it is his opinion that if Mr. King's concepts had been made public, then a wide variety of tower constructions would have appeared during the 1991-1997 time frame in Central Florida; however, Mr. Todd is not aware of any such development (Tab 5, ¶7).

As to the September, 1995 issue of *Powerboat* magazine, Mr. Todd examined this photograph with a magnifying glass and finds the photograph to be deficient in disclosing anything about an

appropriate construction for a wakeboard tower that would meet the technical criteria discussed previously in his affidavit. In Mr. Todd's opinion, one skilled in the art could not build a wakeboard tower for a towboat using this photograph, without the additional benefit of the disclosure contained in the '972 design patent or the '350 utility patent (Tab 5, ¶8).

In the closing paragraphs of his affidavit, Mr. Todd notes that "there has been a virtual explosion of wakeboard towers on recreational boats not only...in Central Florida, but throughout the United States" (Tab 5, ¶10). Mr. Todd also describes at ¶11 the events surrounding an attempt by MasterCraft to purchase the '972 design patent, when he was invited to MasterCraft's headquarters in Tennessee. Mr. Todd did meet with MasterCraft; at no time during the meeting was there ever a suggestion that MasterCraft's photographer (i.e., Mr. King) had earlier invented towing towers of the type at issue (Tab 5, ¶11).

Affidavit of James L. Smith (Tab 6). Mr. Smith is the President of Batech, Inc. located in Port Canaveral, Florida. Batech, Inc. was incorporated in 1972 and does business under the trade name "Sunshine Welding". Mr. Smith's company has for many years fabricated a wide variety of aluminum and steel hardware for the marine industry, including radar arches, T-tops, marlin towers, tuna towers and similar structures. Sunshine Welding has also manufactured items and products for various other companies and organizations, many of which have been certified by the U.S. Coast Guard, the Department of Transportation, the U.S. Armed Forces and

various other companies at the Kennedy Space Center (Tab 6, ¶¶1 and 2).

Since 1997, Sunshine Welding has fabricated towing towers for recreational towboats made by Correct Craft and is presently fabricating an average of about twenty towing towers per week for Correct Craft (Tab 6, ¶3). Correct Craft first brought its towing tower design to Sunshine Welding in 1997; prior to that time, Mr. Smith had not seen a towing tower structure designed for the specific purpose of providing a more stable tow for skiers and wakeboarders being pulled behind a recreational towboat (Tab 6, ¶4). Mr. Smith was provided with a good color copy of the cover, page 4 and page 92 of the September, 1995 issue of *Powerboat* magazine, which forms a part of the Protest; Mr. Smith also had an opportunity to see an original of that issue of the magazine. Additionally, he was provided with copies of the October 26, 2000 declaration of Mr. Ron Schmitt and the '350 patent. After carefully reviewing those materials, Mr. Smith expresses his considered opinion that the opinion of Mr. Ron Schmitt in his declaration contained in the Protest is incorrect (Tab 6, ¶6). In support of his opinion, Mr. Smith makes the following observations at ¶¶7-10 of his affidavit. First, even a careful scrutiny of the upper photograph on page 4 of the September, 1995 issue of *Powerboat* magazine does not reveal several key features of the Correct Craft design such as (a) the construction details of the tower, (b) how the tower structure is attached to the hull, (c) whether the tow rope is centrally attached to a horizontal bridging

member, (d) the relationship of the tower structure to the operator position, and (e) the relationship of the tower structure to the lateral and side windshield portions (Tab 6, ¶7). Second, Mr. Smith notes that the text at pages 4 and 92 associated with the *Powerboat* magazine photograph does not provide any further disclosure of the tower construction other than that which is shown in the photograph (Tab 6, ¶8). Third, Mr. Smith notes that the boat shown in the photograph appears to be a fishing hull (i.e., having a V-bottom). He observes that the combination of a photo tower on a fishing hull would not reasonably lead him to conclude that the photograph discloses a towing tower useful with recreational towboats for skiers and wakeboarders (Tab 6, ¶9). Summarizing his opinion, Mr. Smith notes that the photograph and article at pages 4 and 92 of this magazine "would not reasonably lead me to the specific towing tower construction disclosed in U.S. Patent 5,979,350 without the benefit of a hindsight analysis using the patent as a guide." (Tab 6, ¶10).

Declaration of Carlos Rivero (Tab 7). Mr. Rivero is a permanent resident of Orlando, Florida, and is presently a pre-med student at Tulane University in New Orleans (Tab 7, ¶1). Mr. Rivero took up the sport of wakeboarding in 1995. At that time, the only equipment available for providing an elevated tow rope attachment point were elevated pylons. However, Mr. Rivero found that boats having elevated pylons tended to be unstable during use (Tab 7, ¶2). Between 1995 and 1998, Mr. Rivero competed in a number of wakeboarding competitions, and in 1998 won the Junior

National Championship in that sport. Some time in 1997 or 1998, Mr. Rivero recalls that Correct Craft came out with its towing tower and he had an opportunity to perform wakeboarding tricks while being towed behind a Correct Craft **NAUTIQUE** towboat fitted with one of these new towers. He found the towing tower to be a significant improvement over extended pylons (Tab 7, ¶3). At no time prior to its introduction did Mr. Rivero ever see a towing tower construction like that of Correct Craft (Tab 7, ¶4).

Affidavit of Dean Lavelle (Tab 8). Mr. Lavelle is a former professional athlete on the water skiing and wakeboarding tours; he is presently self-employed as an instructor under the business name "Lavelle Train Station" (Tab 8, ¶1). Mr. Lavelle notes that because of a temperate climate and numerous lakes, recreational water sports such as water skiing, knee boarding and wakeboarding flourish in the Central Florida area. Mr. Lavelle himself has been involved as a professional athlete in recreational water sports for eleven years, and since 1992 has been actively involved in wakeboarding in Central Florida (Tab 8, ¶2).

At ¶3 of his affidavit, Mr. Lavelle describes what are known as "aerial tricks," where the athlete seeks to jump as high as possible; the athlete's ability to perform these aerial tricks is enhanced if the attachment point of the tow rope is elevated to a height substantially greater than the deck and sides of the tow boat. Thus, the wakeboarding sport has always had a need for an elevated tow rope attachment point (Tab 8, ¶3). Prior to 1997, this long-standing need for an elevated attachment point was being

met with the use of extended pylons that attach at a central location to the floor of the boat (Tab 8, ¶4). In the Fall of 1996, Correct Craft requested that Mr. Lavelle experimentally evaluate a new wakeboarding towing tower. This was done in two phases; first, with Correct Craft personnel on Lake Jessamine, and then with a towboat having a mounted tower delivered to Mr. Lavelle's home at Lake Sawyer. Mr. Lavelle was towed behind this boat while performing various wakeboarding tricks, in order to evaluate the tower design. Mr. Lavelle found that Correct Craft's new wakeboard tower design dramatically improved the stability of the boat and thus the performance of wakeboarding tricks when compared to elevated pylons (Tab 8, ¶5).

Mr. Lavelle is very familiar with the "Hit It" performance video marked by FLF Films, Inc.; in fact, Mr. Lavelle is one of the wakeboarding athletes depicted in that video. He notes that the portion of the video in which he is performing was taken on the Conway chain of lakes (in Orlando) and in the Florida Keys; the wakeboarding tricks that he performed for the video were not carried out in a public setting (Tab 8, ¶6). Mr. Lavelle notes that the photography tower used for a portion of the video is attached to the bottom of the boat rearwardly of the operator station (Tab 8, ¶¶7-8). Significantly, Mr. Lavelle found that the Correct Craft tower which he evaluated in 1996 was substantially more stable and gave a much more consistent pull than the photo boat used in the video (Tab 8, ¶9).

Affidavit of William N. Snook (Tab 9). Mr. Snook is one of the inventors; he has resided in Orlando, Florida continuously since 1983 and for the past seventeen years has been employed first as an engineer then as the engineering manager at Correct Craft, Inc. He received a Bachelors degree in mechanical engineering from Pennsylvania State University in 1973 (Tab 9, ¶¶1 and 2). As the engineering manager at Correct Craft, Mr. Snook oversees the conception, design and development for a large variety of projects, ranging from towboat hull designs to accessory equipment designs, such as the towing tower and methods which are the subject of the '350 patent (Tab 9, ¶3).

Mr. Snook notes that, prior to the development of the towing tower which is the subject of the '350 patent, recreational tow boats use extended pylons to elevate the tow rope attachment point, even though these extended pylons presented several technical problems (Tab 9, ¶4). He notes that during the building of the first tower which is the subject of the '350 patent, and even later with production models, the inventors were very concerned about the effect upon the towing tower, the attachment points and the towboat caused by the substantial horizontal forces exerted by the tow rope, and also the effect that changing directions of the force caused by movement of the athlete being towed might have. Their concerns in this regard were made more complex by the fact that many towboat hull designs have non-planar and/or non-horizontal surfaces at the location where the attachment points would be made (i.e., just forward of the windshield, and just aft or adjacent to

the rear of the windshield) (Tab 9, ¶5).⁵ To deal with these technical problems and overcome the instability of extended pylons, Mr. Snook describes the initial design of the towing tower, and the later design which is shown in the '972 design patent, Figures 1 and 2 of the '350 utility patent (Tab 9, ¶6). With these technical features in mind, the construction of the first prototype was carefully monitored during the testing by Dean Lavelle, which is described above and at Tab 8. Correct Craft continued to monitor the construction of later production models of the towing towers, in order to be satisfied that these tower structures met acceptable criteria for tower and attachment point strength and durability, and overall stability when mounted on a recreational towboat (Tab 9, ¶7).

Mr. Snook notes that he is frequently required to conduct testing operations on product designs, and has conducted or monitored such testing and/or evaluation operations on dozens of lakes around Central Florida. Also in connection with his responsibilities, Mr. Snook frequently attends boat shows, trade exhibitions and the like, having attended approximately forty such events since 1990 (Tab 9, ¶8). He notes that at no time prior to 1997 while engaging in all of those activities did he ever observe a towing tower useful with recreational towboats remotely similar to that which was designed by the inventors in the Fall of 1996 (Tab 9, ¶9).

⁵This same concern is discussed in a sidebar to the January/February 2001 *BoatingLife* article at Tab 2.

Mr. Snook carefully reviewed the materials submitted by MasterCraft with its Protest. As to the photograph at page 4 of the September, 1995 issue of *Powerboat* magazine, Mr. Snook states that the details of the photo tower construction shown in that photograph cannot be determined even after reviewing both the enlarged version of the photograph which MasterCraft attached to the Protest at Exhibit 1, and more recently, an original version of the magazine. Mr. Snook finds that the magazine photograph and the accompanying article are totally insufficient to enable anyone skilled in the field to understand how to construct a production model of a towing tower for a towboat, so as to meet the technical criteria which he discusses in ¶¶5 and 6 of his affidavit. Mr. Snook further notes that the fact that no recreational towboat manufacturer came out with a production towboat tower until more than two years after this article is a clear indication that it did not teach anyone skilled in the field how to design such a tower (Tab 9, ¶11).

During the Summer of 1998 or 1999, Correct Craft was invited by *Powerboat* magazine to participate in a test of wakeboarding towboats on Lake Mohave along the Colorado River. In order to participate in that test, Mr. Snook flew to Arizona and picked up a Correct Craft **NAUTIQUE** towboat from an Arizona dealer. That towboat had a towing tower essentially identical to that shown in Figures 1 and 2 of the '350 patent. Mr. Snook then trailered the boat to Lake Mohave, and observed *Powerboat* magazine's tests over

a period of days. During that time, the magazine's photographer took photographs of the tests from a photo tower mounted on a 23-foot Nordic fishing boat having a V-shaped hull. Mr. Snook believes this photo boat is the same boat shown at page 4 of the September 1995 issue of *Powerboat* magazine. At no time did Mr. Snook witness a wakeboarder or skier being towed behind this boat. On one of the days of the test, Mr. Snook was invited to ride on *Powerboat* magazine's Nordic photo boat; although he was at the tests with a **NAUTIQUE** towboat having the patented wakeboard tower thereon (and which was photographed by this same photographer), at no time did the photographer make any statement in his presence that the technique of being towed from Correct Craft's towing tower was in any way similar to the magazine's prior activities (Tab 9, ¶12).

At ¶¶13-15, Mr. Snook notes various deficiencies in the teachings of the "Hit It" video and the activities allegedly described in the King declaration. At ¶16 of his affidavit, Mr. Snook expresses an opinion diametrically different than that of Mr. Ron Schmitt.

Affidavit of Lawrence J. Meddock (Tab 10). Mr. Meddock is employed as the Vice President for marketing of special events at Correct Craft (Tab 10, ¶1). Mr. Meddock notes that Correct Craft is the oldest continuous manufacturer of inboard boats specifically designed for use in recreational water sports, such as skiing, knee boarding and wakeboarding. In his job, Mr. Meddock is responsible

for keeping close track of new developments in these recreational water sports, and that he has particular responsibility for evaluating the safety, technical and marketing merits of new equipment and product developments (Tab 10, ¶2).

Attached as Exhibit A to Mr. Meddock's affidavit is the December, 1997 issue of *WakeBoarding* magazine; Mr. Meddock notes that at several pages throughout this magazine, there are photographs of extended pylons being used for wakeboarding in order to provide an elevated tow rope attachment point. Because these extended pylons created instability and risk, Mr. Meddock notes that prior to 1997 Correct Craft refused to mount extended pylons on its boats as original equipment for production boats (Tab 10, ¶3). In 1997, Correct Craft introduced its new towing tower; Mr. Meddock notes that this new towing tower was initially met with considerable derision and skepticism by competitors when it was first introduced. Since then, however, every boat manufacturer which sells inboard towboats in competition with Correct Craft has now copied those designs, as have a number of secondary market equipment manufacturers. As evidence of this, there is attached as Exhibit B to his affidavit the February, 2001 issue of *WakeBoarding* magazine, which is also published by World Publications, Inc. As noted above, this publisher also publishes *WaterSki* magazine and *BoatingLife* magazine (Tab 10, ¶4).

At ¶5 of his affidavit, Mr. Meddock points to advertisements in the February, 2001 issue of *WakeBoarding* magazine, Exhibit B,

that are directed to wakeboard tower products which emulate that of Correct Craft. Thus, a comparison of Exhibits A and B to Mr. Meddock's affidavit clearly establish that extended pylons were being used exclusively with towboats in 1997, despite the instability and risk associated with that equipment. In contrast, by 2001, almost all towboat and add-on equipment manufacturers had essentially discontinued offering extended pylons and were primarily offering towing tower equipment which emulates that of the patented design (Tab 10, ¶6).

Mr. Meddock describes a meeting during November 2000 between officers of Correct Craft and officers of MasterCraft, at which time MasterCraft requested a license under the '350 patent on terms and conditions extremely favorable to MasterCraft, and threatened to file the Protest if those terms were not met. Correct Craft refused, and the Protest was then filed by MasterCraft's attorney. Mr. Meddock notes, however, that Correct Craft did offer a license to MasterCraft on the same terms and conditions as had been given to existing licensees (Tab 10, ¶7).

At ¶¶8-18 of his affidavit, Mr. Meddock addresses the materials submitted with the Protest. First, Mr. Meddock notes that the minuscule photograph shown in the September 1995 issue of *Powerboat* magazine would not enable one of ordinary skill in the design of equipment of this type to understand how a towing tower useful with conventional inboard towboats could be constructed, without considerable experimentation (Tab 10, ¶8). Second, Mr. Meddock likewise notes that the very brief and transitory scenes in

the "Hit It" video showing a tow rope attached to a photo tower mounted on a fishing boat would not enable one of ordinary skill in the art to understand how to develop a workable towing tower, without a significant level of experimentation.

As to the King declaration, Mr. Meddock testifies that he is very familiar with the facilities at the Orange County Sportsman Association on Lake Sheen, and that those facilities are not open to members of the general public. He also notes that this lake is not publicly accessible, except by passage through several canals from Lake Down, which is several lakes away. Thus, it is extremely unlikely that members of the public were in fact watching the purported events described by Mr. King (Tab 10, ¶¶11 and 12). Mr. Meddock also notes that it is unlikely that employees of *WaterSki* magazine witnessed these events, because that magazine did not later publicize those events. However, the publisher of *WaterSki* magazine, World Publications, did later publish the reports acknowledging Correct Craft's innovation with respect to towing towers. Mr. Meddock notes that he has known Mr. King for many years, and also is familiar with Mr. Reinhart, whose unverified letter is enclosed in the Protest at Exhibit 6. Based upon Mr. Meddock's experiences with Mr. King, he states a belief that it is extremely doubtful that Mr. King would permit any of his photography sessions to be conducted in public; he has this opinion, because it is his experience that Mr. King in fact is careful not to conduct his photographing sessions in public so that his photographs are not "scooped" by amateur photographers. On

this basis, Mr. Meddock finds it "particularly noteworthy that Mr. Reinhart's undated letter at Tab 6 of the Protest addressed to MasterCraft's President makes no reference to members of the public or the media being present." (Tab 10, ¶14; emphasis in original). As to the allegations in Mr. King's declaration at ¶5 that he also conducted a tow of Mr. Reinhart from his photo tower on Lake Tibet-Butler in 1992, Mr. Meddock again notes that it is unlikely that Mr. King would conduct such a photo shoot in public; Mr. Meddock also observes that there is no mention at all of this 1992 activity in the Reinhart letter (Tab 10, ¶15).

At ¶¶16-19 of his affidavit, Mr. Meddock notes that if Mr. King--MasterCraft's freelance photographer--had in fact satisfactorily achieved an elevated towing tower as early as 1991-1992, then it would have been likely for Mr. King to pass that information along to the officers and engineers at MasterCraft. The fact that MasterCraft did not begin marketing towing towers until well after Correct Craft introduced those products in the Spring of 1997 clearly demonstrates, in Mr. Meddock's mind, that the alleged 1991-1992 activities of Mr. King and Mr. Reinhart were not public. Mr. Meddock's beliefs in this regard are bolstered by the fact that, despite his many years of being intimately involved in the recreational water sports industry in Central Florida, he has never heard a single word about Mr. King's alleged developments (Tab 10, ¶16). However, after Correct Craft introduced its towing tower design in the Spring of 1997, not only are new towboats now being fitted with towers emulating Correct Craft's designs, there

has developed a substantial retrofit market for those towers to be mounted on boats already in service. Advertisements for participants in that retrofit market are set out at pages 101-104 of Exhibit B to Mr. Meddock's affidavit (Tab 10, ¶17).

At ¶18 of his affidavit, Mr. Meddock addresses the arguments made by MasterCraft at page 17 of its Protest. Specifically, Mr. Meddock addresses MasterCraft's arguments that any copying of Correct Craft's towing tower design is because of a lack of concern as to the validity of the '350 patent. Mr. Meddock notes that MasterCraft's arguments are deceptive for two reasons. First, some boat and equipment manufacturers have in fact informed Correct Craft that they are willing to pay royalties for a license under the Correct Craft patents, despite MasterCraft's challenge. Second, those manufacturers with whom Correct Craft representatives have spoken and who are presently declining to pay licensing royalties have indicated they are taking this position because representatives of MasterCraft have contacted them, giving assurances that MasterCraft "is going to win the Protest and destroy Correct Craft's patents," or words to that same effect. Therefore, those manufacturers are awaiting the outcome of the Protest to determine what position to take. Further, contrary to MasterCraft's inaccurate representations at the bottom of page 17 of the Protest regarding the size of the companies who have been willing to take a license, Correct Craft is discussing a license arrangement with U.S. Marine/Bayliner and Regal Boats, both of whom are significantly larger than MasterCraft (Tab 10, ¶18). In

closing, Mr. Meddock notes that there were no towing towers for towboats available prior to the introduction by Correct Craft in the Spring of 1997 despite the need for safe equipment to replace extending pylons (Tab 10, ¶19).

The above is that evidence which Correct Craft has been able to gather in the short time since receiving the Examiner's request.

IV. THE MATERIALS SUBMITTED IN THE PROTEST DO NOT RENDER THE CLAIMS UNPATENTABLE

Correct Craft submits that there are two crucial legal issues which the Examiner must take into account when analyzing the material submitted in the Protest. First, a determination must be made as to whether the materials submitted with the Protest contain an enabling disclosure that teaches one of ordinary skill in the art the subject matter recited in the claims of the '350 patent. Second: as to the King and Krehbiel declarations and the unverified Reinhart letter, the Examiner must make a determination as to whether this evidence is credible and legally sufficient. Each of these issues is discussed in the following subsections.

A. The Applicable Law Requires a Prior Art Disclosure to be Enabling

As will be discussed in greater detail below, the prior art submitted in the Protest fails as a matter of law to enable one skilled in the art to practice the claimed invention. The authorities which elucidate the "enablement" requirement are

venerable. In Seymour v. Osborne, 78 U.S. 516, 555 (1870), the Supreme Court used this seminal language to discuss how a prior art patent or publication is to be evaluated in determining whether it contains an anticipatory description of the claimed invention:

Mere vague and general representations will not support (an anticipation) defense, as the knowledge supposed to be derived from the publication (or patent) must be sufficient to enable those skilled in the art or science to understand the nature and operation of the invention, and to carry it into practical use. Whatever may be the particular circumstances under which the publication takes, the account published to be of any effect to support such a defense, must be an account of a complete and operative invention capable of being put into practical operation.

Judge Learned Hand, in Dewey & Almy Chem. Co. v. Mimex Co., 124 F.2d 986, 990, 52 U.S.P.Q. 138, 142 (2d Cir. 1942) expressed the enablement requirement in these terms:

No doctrine of the patent law is better established than that a prior patent or other publication to be an anticipation must bear within its four corners adequate directions for the practice of the patent invalidated. *If the earlier disclosure offers no more than a starting point for future experiments, if its teaching will sometimes succeed and sometimes fail, if it does not inform the art without more how to practice the new invention, it has not correspondingly enriched the store of common knowledge and it is not an anticipation.* (Emphasis added).

The Court of Appeals for the Federal Circuit has likewise consistently required clear and convincing enablement evidence. Rockwell International Corp. v. U.S., 147 F.3d 1358, 1364, 47 U.S.P.Q. 2d 1027, 1031 (Fed.Cir. 1998) (affirming a denial of

summary judgment of anticipation because there were genuine issues of fact as to whether the allegedly anticipatory reference provided an enabling disclosure); In re Paulsen, 30 F.3d 1475, 1478, 31 U.S.P.Q. 2d 1671, 1673 (Fed. Cir. 1994) ("the reference must be enabling and describe the Correct Craft's claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention"); Scripps Clinic & Research Foundation v. Genentech, Inc., 927 F.2d 1565, 18 U.S.P.Q. 2d 1001 (Fed.Cir. 1991) (whether a prior art reference is enabling was a disputed issue of fact not properly resolved by summary judgment); Chester v. Miller, 906 F.2d 1574, 1577 n.2, 15 U.S.P.Q. 2d 1333, 1336 n.2 (Fed.Cir. 1990) ("To be prior art under §102(b) the reference must put the anticipating subject matter at issue into the possession of the public through an enabling disclosure.")

B. Public Use Claims That are Not Substantiated by Contemporaneous Tangible Evidence are Insufficient as a Matter of Law

The Examiner will note that the Protest does not attempt to analyze at all the Federal Circuit authorities requiring independent, contemporary corroborating evidence for a claim of prior public use. The two very recent decisions of the Federal Circuit on this issue are Finnigan Corp. v. ITC, 180 F.3d 1354, 51 U.S.P.Q. 2d 1001 (Fed.Cir. 1999) and Woodland Trust v. Flower Tree Nursery, Inc., 148 F.3d 1368, 47 U.S.P.Q. 2d 1363 (Fed.Cir. 1998). In Finnigan, the Court said:

The law has long looked with disfavor upon invalidating patents on the basis of mere testimonial evidence absent other evidence that corroborates that testimony. The Supreme Court recognized over one hundred years ago that testimony concerning invalidating activities can be "unsatisfactory" due to "the forgetfulness of witnesses, their liability to mistakes, their proneness to recollect things as the party calling them would have recollect them, aside from the temptation to actual perjury. *The Barbed Wire Patent*, 143 U.S. 275, 284 (1891).⁶

In the Woodland Trust case, the Federal Circuit reversed a District Court finding of prior public use based upon oral testimony from several witnesses, even where there was alleged contemporaneous documentation through an undated photograph. Pointing to the prior guidance from the U.S. Supreme Court's 1891 decision in The Barbed Wire Patent, 143 U.S. 275, 284 (1891), the Federal Circuit noted that:

The Supreme Court's view of human nature as well as human recollection, whether deemed cynical or realistic, retains its cogency. This view is reinforced, in modern times, by the ubiquitous paper trail of virtually all commercial activity. It is rare indeed that some physical notes, letters, invoices, notebooks, or a sketch or drawing, or photograph showing the device, a model, (or some other contemporaneous record) does not exist.⁷

⁶51 U.S.P.Q. 2d at 1009-10 (footnote omitted).

⁷47 U.S.P.Q. 2d at 1367. Correct Craft notes that the photograph in Woodland Trust was allegedly contemporaneous with the prior public use; as will be discussed in greater detail below, it is quite apparent that the photograph accompanying the King declaration was not taken contemporaneously with the events described in that declaration.

When the King and Krehbiel declarations are weighed against the evidentiary burden established in the Finnigan and Woodland Trust cases, it is seen that these declarations fall far short of establishing invalidating prior public use or publication.⁸

C. The Protest Materials

The September 1995 Powerboat photograph and article (Exhibit 1) and the Schmitt declaration (Exhibit 13). MasterCraft's own conduct in attaching a blown up version of the photograph on page 4 of this magazine speaks volumes as to why this photograph does not provide an enabling disclosure to one of ordinary skill in the art. The accompanying Todd, Smith, Snook and Meddock affidavits all clearly establish that this photograph would not fairly teach one how to construct the patented tower, without substantial experimentation or without using the '972 design patent or the '350 utility patent as a guide. The Schmitt declaration stated in the most conclusory terms, and no effort is made in that declaration to specifically identify the claimed elements that Mr. Schmitt allegedly can see in the photograph.

The "Hit It" video (Exhibit 2) and the Krehbiel declaration (Exhibit 3). The accompanying affidavit of Dean Lavelle at Tab 8 describes some of the events transpiring during the filming of this

⁸The Beachcombers Int'l decision cited at page 6 of MasterCraft's Protest is inapposite because there was contemporaneous documentary corroboration of the "public use" event; 31 U.S.P.Q. at 1657. MasterCraft has not presented any such contemporaneous documents.

video, and that the events in question were not conducted in a public setting. Further, Mr. Lavelle notes that any tow from the photograph tower of the fishing boat being used for the video session is only shown in a transitory manner, and provided a significantly different "pull" than that he experienced when testing the patented tower for Correct Craft. The Krehbiel declaration is wholly inadequate under the Finnigan and Woodland Trust decisions, discussed above, because the declaration does not provide any contemporaneous documentary evidence which supports the assertions in this declaration that FLF Films, Inc. first shipped the video to customers not later than February 1, 1997. If this is in fact true, there should be substantial documentary evidence supporting that allegation. In fact, however, Mr. Krehbiel gives this declaration despite the fact that he apparently left FLF Films in 1997.

Finally, this video does not constitute prior art to a priority date based upon the '972 patent, because the alleged receipt date by customers before March 1997 was after Correct Craft's invention date, and less than a year prior to the filing date of the '972 patent.

The King declaration (Exhibit 5) and the unverified Reinhart letter (Exhibit 6). The one and a half page King declaration is drafted with very sparse language. This declaration is notable for the lack of real information that it provides, and also for the lack of any contemporaneous documentation (despite the fact that the declaration is that of a professional photographer, who would

be expected to record events with photographs). Missing from the King declaration is any identification of the alleged employees of *WaterSki* magazine and other performers, or the approximately twenty other persons allegedly watching the events from a dock. The Reinhart letter does not corroborate the events described in the King declaration; to the contrary, the Reinhart letter makes no mention of any onlookers watching these alleged events. Further, while the King declaration references events allegedly transpiring in 1992 on Lake Tibet-Butler, the Reinhart letter also makes no mention of any 1992 events.⁹

The above discussion, when weighed against the requirements for the legal sufficiency of evidence of alleging prior public use as set out in the Finnigan and Woodland Trust decisions is alone enough for the Examiner to disregard the King declaration and the Reinhart letter entirely. When weighed against the *WaterSki* and *BoatingLife* articles at Tabs 1 and 2, the Hotz affidavit at Tab 3 and the Napolitano affidavit at Tab 4, it is seen that even more serious questions arise. These questions include the following. If representatives of *WaterSki* magazine were present in 1991 as suggested in the King declaration, why was *WaterSki* magazine's representatives so startled to see Correct Craft's construction, as discussed in the articles at Tabs 1 and 2? In the King declaration, the boat shown in the photograph is described as "my

⁹The Rivero declaration and the Lavelle affidavit (Tabs 7 and 8), both from seasoned wakeboarders, call the alleged public use described in the King declaration into serious question.

boat" throughout the declaration--yet the Hotz affidavit makes it clear that Mr. King did not record title in that boat until 1996. Finally, the Napolitano affidavit indicates that the Mercury Marine outboard motor affixed to the back of the boat shown in the photograph with the King declaration is most likely a 1997 model (Tab 4).

The remaining materials in the Protest (Exhibits 7-12). The ancillary material included with the Protest does not adversely affect the claims of the patent.

V. SUMMARY AND CONCLUSION

No doubt the Examiner will wish to review the prosecution history of the '350 patent. From that review, the Examiner will immediately recognize that there was a substantial amount of prior art considered during the prosecution of the application which became the '350 patent, much of which is far more relevant to Claims 1-49 in the '350 patent than the material submitted in the Protest. During that prosecution, the Examiner negotiated with Correct Craft the language of Claims 1-49, which is specifically directed to the method and apparatus for improving the aerial characteristics of a skier or wakeboarder being towed behind a vessel "while maintaining the stability of the vessel..." (quoting from Claim 1). Claim 1 specifically recites a method that includes the step of fitting first and second vertical support structures to first and second sides of the boat, with a generally horizontal bridging portion with a tow rope attached to that bridging portion,

and with the structure being pivotally attached for rotation to a horizontal position. The 1995 *Powerboat* photograph simply does not meet this recitation, nor does the "Hit It" video or the King declaration; as noted by Mr. Todd in his affidavit (Tab 5), the tow rope attachment point is along a vertical plate which is welded to a truss, with the truss not being attached to the sides of the boat, but instead being attached to opposing stanchions. Claims 2-11 all depend upon Claim 1 and include specific additional limitations which define over the prior art, including the materials submitted with the Protest.

Claim 12 is also a method claim directed to towing a performer while maintaining the stability of the vessel, and in which the specific recitation of the steps relating to the details of the construction are more specific than that recited in Claim 1. It is most difficult to understand how Mr. Schmitt in his declaration at Exhibit 13 in the Protest can assert that the minuscule photograph in the 1995 *Powerboat* article teaches him the particular method recited in Claim 12. Correct Craft submits that the total absence of a rigorous evaluation of the limitations of Claim 12 against that photograph in Mr. Schmitt's declaration proves the point. Claims 13-21 depend upon Claim 12 and include various additional limitations also not found in the prior art or the materials submitted with the Protest.

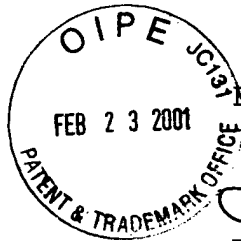
Claims 22-37 and 41-49 are all apparatus claims directed to the construction details of the towing tower design disclosed in the '350 patent. In Appendix A to the Protest, MasterCraft

acknowledges that the various specific limitations of these apparatus claims are not anticipated by any of the materials contained in the Protest. Rather, the Protest urges the Examiner to combine a hodge podge of prior art, without any analysis of whether there is any suggestion for combining that art. It is respectfully submitted that all Claims 1-49 distinguish over the prior art of record and the Protest materials.

The Examiner should understand that the Protest was submitted by one of Correct Craft's most aggressive competitors. In its zeal, MasterCraft has submitted a Protest containing the King declaration and the Reinhart unverified letter, which are directly inconsistent with each other and are unsupported by contemporaneous tangible evidence which corroborates the alleged events. Correct Craft's own brief investigation as to the title of the boat and the vintage of the motor shown on the boat in the photograph accompanying the King declaration raises serious questions about the accuracy of that declaration. The 1995 *Powerboat* photograph does not, under any circumstances, constitute a teaching disclosure. The "Hit It" video with its dozens of scenes depicting the use of extended pylons, and its two transitory scenes without any details showing a tow rope apparently tied to the upper portion of a photography tower also is not a truly enabling disclosure for one skilled in the art. Even the date that this video was publicly available is not proven in the manner required by Federal Circuit authority, since the Krehbiel declaration is unsupported by any tangible contemporaneous evidence.

For the above reasons, Applicant Correct Craft respectfully requests the Examiner to reissue the '350 patent with the inventorship corrected and with priority based upon the application which became the '972 patent.

Correct Craft's undersigned counsel stands ready to discuss this matter with the Examiner and requests that the Examiner telephone the undersigned at the Examiner's convenience if a telephone interview will expedite placing this reissue application in a condition for allowance.



Respectfully submitted,

Herbert L. Allen
Registration 25,322
Allen, Dyer, Doppelt, Milbrath
& Gilchrist, P.A.
255 S. Orange Ave., Suite 1401
P. O. Box 3791
Orlando, Florida 32802
(407) 841-2330

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: COMMISSIONER OF PATENTS AND TRADEMARKS, WASHINGTON, D.C. 20231, on this 16TH day of February, 2001.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue Application of:)

BORDEN M. LARSON, ET AL.)

Reissue of: U.S. Patent No. 5,979,350)

Reissue Appln. No.: 09/613,154)

Filed: June 30, 2000)

For: WATER SPORT TOWING
APPARATUS AND METHOD)

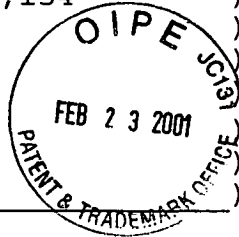
Examiner:

Mr. Stephen Avila

Group Art Unit: 3617

Current Status: Pending

REISSUE LITIGATION



Box REISSUE
Commissioner for Patents
Washington, D.C. 20231

APPENDIX TO APPLICANT'S REPLY TO PROTEST

- | | | |
|--------|---|------------------------------------------------------------|
| TAB 1 | - | THE 1998 WATERSKI MAGAZINE TESTS |
| TAB 2 | - | THE JANUARY/FEBRUARY 2001 ISSUE OF
BOATINGLIFE MAGAZINE |
| TAB 3 | - | THE AFFIDAVIT OF MS. SHELLEY HOTZ |
| TAB 4 | - | AFFIDAVIT OF CARL M. NAPOLITANO |
| TAB 5 | - | AFFIDAVIT OF ROBERT TODD |
| TAB 6 | - | AFFIDAVIT OF JAMES L. SMITH |
| TAB 7 | - | DECLARATION OF CARLOS RIVERO |
| TAB 8 | - | AFFIDAVIT OF DEAN LAVELLE |
| TAB 9 | - | AFFIDAVIT OF WILLIAM N. SNOOK |
| TAB 10 | - | AFFIDAVIT OF LAWRENCE J. MEDDOCK |

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue Application of:

BORDEN M. LARSON, ET AL.

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APPARATUS AND METHOD)

Examiner:

Mr. Stephen Avila

Group Art Unit: 3617

Current Status: Pending

Box REISSUE
Commissioner for Patents
Washington, D.C. 20231

AFFIDAVIT OF SHELLEY HOTZ

State of Florida:

: ss

County of Orange:

I, Shelley Hotz, having first appeared before the undersigned officer who is duly authorized to administer oaths in the State of Florida did depose and say:

1. I am employed as a paralegal with the law firm of Allen, Dyer, Doppelt, Milbrath & Gilchrist, with offices in Orlando, Florida. I makes this Affidavit based upon my personal knowledge.

2. Our law firm represents Correct Craft, Inc., of Orlando in intellectual property matters. On February 7, 2001, I was given

a photocopy of a photograph of a boat, a copy of which is appended as Exhibit A. I was requested to conduct an internet search of the records of the State of Florida for the boat registration number shown on the boat in Exhibit A, namely registration FL9976CP.

3. In the course of undertaking the requested search, I obtained a printout from Data Base Technologies, Inc., a firm which provides information to law enforcement and related professional licensees only, which printout is appended as Exhibit B. That printout shows that the boat bearing Florida Registration No. FL9976CP was registered to Tom King Inc., 7401 Chancery Lane, Orlando, FL 32809, and that the title to that company for the boat was issued on April 19, 1996.

4. As a further check on the 1996 title issuance listed in the printout of Exhibit B, I contacted Investigative Legal Services (ILS), a company that provides assistance to lawyers in obtaining copies of documents from the governmental offices for the State of Florida in Tallahassee, Florida. I requested a printout confirming the issuance of the title. Thereafter, I received from Investigative Legal Services a facsimile, a copy of which is appended as Exhibit C. The Vehicle Inquiry Report of Exhibit C was run on February 12, 2001, and confirms that the title to the

boat bearing Florida Registration No. FL9976CP was issued to Tom King Inc. on April 19, 1996. As a further backup to determine the correctness of the search by ILS, contact was made with our firm's law clerk in Tallahassee, who obtained a certified copy of the Vessel Inquiry Report on February 14, 2001. A true and correct copy of that certified Report is attached as Exhibit D.

FURTHER AFFIANT SAYETH NOT.

Shelley Hotz
Shelley Hotz

Subscribed and sworn to before me

this 15 day of February, 2001

Nancy White

Notary Public

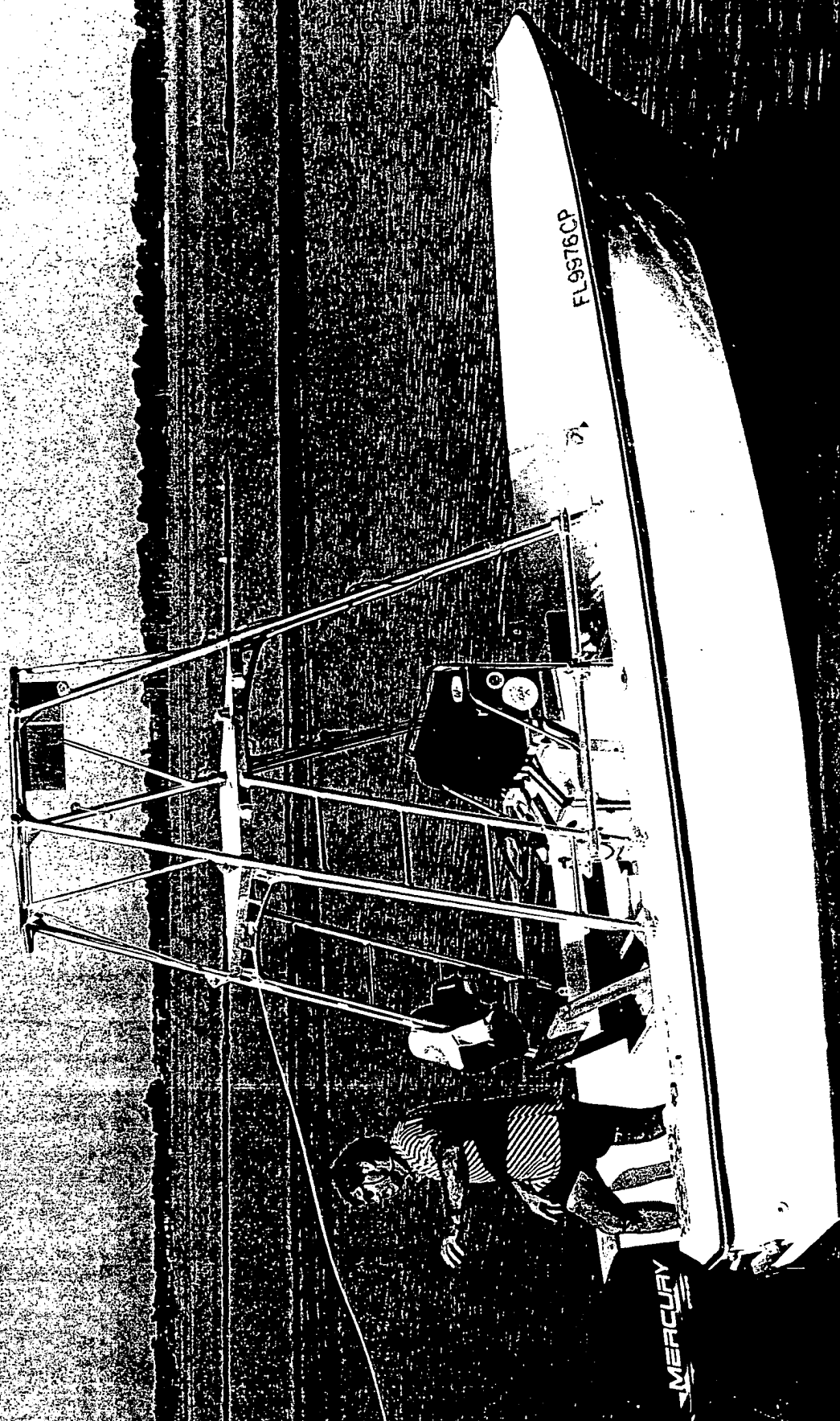
My commission expires:

Personally known to me ☒

Produced identification of:

NOTARY PUBLIC - STATE OF FLORIDA
NANCY WHITE
COMMISSION # CC732092
EXPIRES 7/23/2002
BONDED THRU ASA 1-888-NOTARY1

A



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Detail

Watercraft

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FLORIDA BOAT REGISTRATIONS

BOTH OWNER AND REGISTRANT

Name: TOM KING INC
Address: 7401 CHANCERY LANE
ORLANDO, FL 32809
County: ORANGE
SSN: 592-98-4560
Resident Status: FLORIDA RESIDENT

BOAT INFORMATION:

Registration Number:	FL FL9976CP	Registration Date:	07/07/1998
Hull Id:	RGM04680M81B	Expiration Date:	06/30/1999
Decal Number:	0574706	Decal Year:	
Title Number:	0000870056	Title Issued:	04/19/1996
Title Status:		Title Pending:	
Previous Title State:		Original Title Date:	
Manufacturer/Make:	REGAL	Model:	
Vessel Type:	OPEN MOTORBOAT	Model Year:	1981
Type of Use:	PLEASURE VESSEL		
Hull Construction:	FIBERGLASS		
Type Propulsion:	OUTBOARD	Length:	20'
Type of Fuel Used:	GAS	Registration Status:	INACTIVE

MTRFQ054
COUNTY/AGENCY: 68/05

FLORIDA DEPARTMENT OF HIGHWAY SAFETY
VESSEL INQUIRY REPORT

PAGE: 1
RUN DATE: 02/12/2000
RUN TIME: 12:27:55

VESSEL INFO

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YEAR MAKE: 1981
MAKE/INHOUSE: /
HULL MATERIAL: FG
MANUFACTURER: RGM/1
PROPULSION TYPE: OB
WATER TYPE:

TITLE INFO

TITLE NUMBER: 870056
SALVAGE TYPE:

PENDING? NO

ISSUE DATE: 04/19/1996
EFS STATUS:

OWNER INFO

FEID/DL NUMBER: 592984560
BIRTH DATE/SEX: /
OWNER NAME: TOM KING INC
OWNER ADDRESS: 7401 CHANCERY LANE
ORLANDO, FL 32809

OWNER NUMBER: 1
RES COUNTY: 7

REGISTRATION INFO

FL NUMBER: FL9976CP
OOS REG NUMBER:
DOCUMENTED NUM:
VESSEL STATUS: FL
REG USE: PL
CLASS CODE: 100

DECAL NUMBER: 00553306
DECAL YEAR: 2001
ISSUE DATE: 06/15/2000
EXPIRATION DATE: 06/30/2001
REG ONLY REASON:

LIEN HOLDER INFO

FEID/DL NUMBER:
LIEN DOB/SEX: /
LIEN HLDR NAME:
LIEN HLDR ADDR: NO LIENS ON FILE

LIEN NUMBER:
RES COUNTY:

CURRENT OWNER

MTRFQ054

COUNTY/AGENCY: 68/05

FLORIDA DEPARTMENT OF HIGHWAY SAFETY

VESSEL INQUIRY REPORT

PAGE: 1

RUN DATE: 02/14/2001

RUN TIME: 13:54:18

VESSEL INFO

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LENGTH FT/INCH: 20 /9
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DRAFT FT/INCH: 0 /0

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MAKE/INHOUSE: /
HULL MATERIAL: FG
MANUFACTURER: RGM/1
PROPULSION TYPE: OB
WATER TYPE:

TITLE INFO

TITLE NUMBER: 870056
SALVAGE TYPE:

PENDING? NO

ISSUE DATE: 04/19/1996
EFS STATUS:

OWNER INFO

FEID/DL NUMBER: 592984560
BIRTH DATE/SEX: /
OWNER NAME: TOM KING INC
OWNER ADDRESS: 7401 CHANCERY LANE
ORLANDO, FL 32809

OWNER NUMBER: 1
RES COUNTY: 7

REGISTRATION INFO

FL NUMBER: FL9976CP
OOS REG NUMBER:
DOCUMENTED NUM:
VESSEL STATUS: FL
REG USE: PL
CLASS CODE: 100

DECAL NUMBER: 00553306
DECAL YEAR: 2001
ISSUE DATE: 06/15/2000
EXPIRATION DATE: 06/30/2001
REG ONLY REASON:

LIEN HOLDER INFO

FEID/DL NUMBER:
LIEN DOB/SEX: /
LIEN HLDNR NAME:
LIEN HLDNR ADDR:

LIEN NUMBER:
RES COUNTY:

NO LIENS ON FILE

FEB 14 2001

TALLAHASSEE, FLORIDA
I, William T. Joyce, Director, Division
of Motor Vehicles of the State of Florida
hereby certify that this is a true and
correct copy of the Motor Vehicle record
on file in this office.



William T. Joyce
WILLIAM T. JOYCE, DIRECTOR
DIVISION OF MOTOR VEHICLES
DEPT. OF HIGHWAY SAFETY AND
MOTOR VEHICLES

4

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue Patent Application for
Patent No. 5,979,350 of:

BORDEN M. LARSON ET AL.

Serial No. 09/613,154

Filing Date: June 30, 2000

For: **WATER SPORT TOWING APPARATUS
AND METHOD**

Examiner: **Stephen Avila**

Art Unit: **3612**

Asst. Commissioner for Patents
Washington, D.C. 20231

Sir:

AFFIDAVIT OF CARL M. NAPOLITANO

STATE OF FLORIDA
COUNTY OF ORANGE

I, Carl M. Napolitano, having first appeared before the undersigned officer who is duly authorized to administer oaths in the State of Florida, did depose and say:

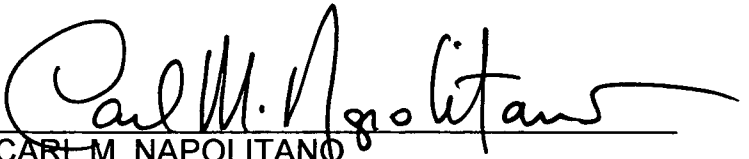
1. As part of a review of the protest filed in the above reissue application, I was asked to determine the vintage of the Mercury Marine outboard motor shown in the color photograph which forms a part of the Declaration of Tom King. A copy of that photograph is attached as Exhibit A.

2. As part of that investigation, on Wednesday, February 14, 2001, I visited a retail boat dealer located in Orlando, Florida. I met there with the owner, Mr. Jeff Hood, and his staff.

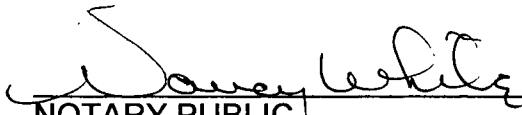
3. My visit with the dealer included a tour of used boats and motors having Mercury Marine motors, as well as a computer database search of Mercury outboard motors.

4. From my investigation, I learned that the motor shown in the attached photograph is likely a 1997 model of a Mercury Offshore motor having a V-6 engine and rated at 200 HP. Investigation of the database information and the view of dealer staff indicate that the cowling on the motor shown in the photograph was available on Mercury outboard motors beginning in either 1995 or 1996. However, because of the "OFFSHORE" decal on the cowling on the motor in the photograph, this motor is most likely a 1997 model.

FURTHER AFFIANT SAYETH NAUGHT.


CARL M. NAPOLITANO

Sworn to and subscribed before me by the said Carl M. Napolitano, who is personally known to me, this 15th day of February, 2001.


NOTARY PUBLIC
My Commissioner Expires:

NOTARY PUBLIC - STATE OF FLORIDA
NANCY WHITE
COMMISSION # CC732092
EXPIRES 7/23/2002
BONDED THRU ASA 1-888-NOTARY1

5

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue Application of:)	
BORDEN M. LARSON, ET AL.)	
Reissue of: U.S. Patent No. 5,979,350)	Examiner:
Reissue Appln. No.: 09/613,154)	Mr. Stephen Avila
Filed: June 30, 2000)	Group Art Unit: 3617
For: WATER SPORT TOWING)	Current Status: Pending
APPARATUS AND METHOD)	

Box REISSUE
Commissioner for Patents
Washington, D.C. 20231

AFFIDAVIT OF ROBERT TODD

State of Florida :
County of Orange : ss

I, **ROBERT TODD**, having first appeared before the undersigned officer who is duly authorized to administer oaths in the State of Florida did depose and say:

1. I am 39 years of age and am an inventor in the above identified matter. This affidavit is based upon my personal knowledge.

2. I am a master welder with 20 years experience. Since 1992 I have been a welder in the marine industry, and since 1994 I have done business as Todd's T-Tops and Towers, located in Winter

Park, Florida. Todd's T-Tops specializes in the construction of a wide variety of radar arches, tuna towers, outriggers and other hardware for boats of all sizes. A reproduction of an advertisement for towing towers that are made by our company is attached as Exhibit A. Prior to forming Todd's T-Tops, I worked as a welder for the Pipe Welders Company of Fort Lauderdale, Florida. That company also fabricated a variety of metal structures and fittings for boats.

3. In the Fall of 1996, I was asked by Correct Craft, Inc. to participate in the design of a towing tower to be mounted over the operator's station of Correct Craft's famous **NAUTIQUE** recreational towboats.

4. After conducting an analysis of the number and location of welds which might affect the ability of the tower construction to withstand rearward forces that would be exerted on the tower by a wakeboarder being towed behind the boat, it was decided to use a tower construction that employs a pair of arches defining four legs, with two of the legs mounted on opposite gunwales of the boat forward of the windshield of the towboat, and two legs also mounted on the opposite gunwales aft of or adjacent to the windshield. At the time, we recognized that each arch could extend across the beam of the boat in a fore and aft pair, or alternatively each arch could be mounted to one gunwale with the other arch mounted to the opposing gunwale. The construction was also designed with

longitudinally extending horizontal bars welded at attachment points fore and aft to the respective arches, and with a tow rope connecting element fixed directly to the aft, generally horizontal portion of the construction. This last feature was very important, because the horizontal stresses of a towed athlete can be more easily transmitted across a horizontal bridging portion than to a vertically-extending element. This construction that was selected as the original prototype is depicted in Figures 1-7 of U.S. Design Patent 409,972 (Exhibit B) and in Figures 1, 2 and 6-8 of U.S. Patent 5,979,350 (Exhibit C). This construction shown in both of the patents is the subject of the towing apparatus recited in the claims of the '350 patent.

5. It has been brought to my attention that the MasterCraft Company has filed a protest with respect to the above-identified reissue application. I have had an opportunity to review portions of that protest, and have the comments set out in ¶¶6-11 below.

6. I have carefully studied the declaration of Tom King set out at Tab 5 of the protest, and have examined in careful detail the color photograph which accompanies that declaration. It is my considered opinion that not only was the tower structure shown in the photograph not designed for towing individuals, it is further my specific opinion that if a person were to attach the tow rope as is shown in this photograph, it is likely that after a short period of time, the tow rope would tear away from the point where the tow

rope is attached. In studying the photograph with a magnifying glass, I note that the tow rope is attached to a small, central flat plate which appears to be welded at the top to the bottom edge of a platform, and at the bottom to a truss which is, in turn, further attached to the bottom of the platform with left and right hand additional small plates, and at the bottom of the truss to opposing stanchions of the tower. In my experience, a small gauge plate like that to which the tow rope in the photograph is attached will likely give way after a short period of time if subjected to the types of forces that would be applied by a wakeboarder being pulled behind the boat from that attachment point. To assist the reader in understanding my above remarks, I attach as Exhibit D an enlarged copy of the King photograph.

7. For these reasons, it is my opinion that it was highly unlikely that Mr. King conducted any significant level of use of his tower for towing purposes. My opinion in that regard is bolstered by the fact that I have been closely attuned to tower developments in the marine industry here in Florida for the last 15 years, and have never seen a tower used in a manner like that allegedly used by Mr. King. Given the difficulties that wakeboarders have experienced over the years with extended pylons, it is my considered opinion that if Mr. King's concepts had been made public, then a wide variety of tower constructions would have appeared during the 1991-1997 time frame here in Central Florida.

In fact, I am not aware of a single such development, and Mr. King's declaration points to none.

8. I have also recently reviewed an original copy of the September 1995 issue of *Powerboat* magazine, and have examined with a magnifying glass the photograph of a photo boat at page 4 of that magazine. (I saw this photograph for the first time within the last 2-3 weeks). Frankly, that photograph is so deficient in disclosing anything about an appropriate construction for a wakeboard tower that would meet the technical criteria discussed in ¶4 above, I cannot envision that anyone skilled in the art could express the opinion that this photograph and the associated article would permit them to build a wakeboard tower for a towboat, without the additional benefit of the disclosure contained in the '972 design patent or the '350 utility patent. I do note with interest that Mr. Ron Schmitt does not explain the basis for his opinion, nor does he attempt to specifically analyze the features recited in the claims of the '350 patent in an effort to support his opinion.

9. There is a further reason why a tower manufacturer like Mr. Schmitt would not likely find the photography at page 4 of the September 1995 *Powerboat* magazine to be a source of ideas for tower constructions. When one examines the entire September 1995 issue of that magazine, it becomes quite clear that it is directed to offshore power boats, with no articles or advertisements relating to recreational towboat activities. Indeed, I have carefully

examined this magazine and cannot find a single advertisement from one of the traditional recreational towboat manufacturers. Thus, if a tower manufacturer like Mr. Schmitt or myself were looking for ideas for new tower constructions, it is highly unlikely that we would look at this magazine at all.

10. In closing, I also note that since the development of the wakeboard tower which is the subject of the '972 design patent (Exhibit B) and the '350 utility patent (Exhibit C), there has been a virtual explosion of wakeboard towers on recreational boats not only here in Central Florida, but throughout the United States. Prior to Correct Craft's introduction of these towers in 1997, I never saw any such tower constructions; now they are everywhere throughout the United States, and are available on recreational towboats as original equipment, or through an extensive secondary market for those towers. Todd's T-Tops and Towers participates in that market under license from Correct Craft.

11. At about the time the '972 design patent issued, I received a telephone call from Mr. John Dorton, the President of MasterCraft. Mr. Dorton expressed an interest in buying the design patent, and invited me to MasterCraft's headquarters in Tennessee. I traveled to MasterCraft and met with Mr. Dorton and other MasterCraft corporate representatives. At no time during those meetings was there ever a suggestion that MasterCraft's photographer in the Orlando area (i.e., Mr. Tom King) has earlier

invented that which is the subject of the '972 design patent. On the contrary, MasterCraft expressed a strong interest in buying the patent. MasterCraft also had Todd's T-Tops build its first wakeboard tower.

FURTHER AFFIANT SAYETH NOT.

Robert Todd
ROBERT TODD

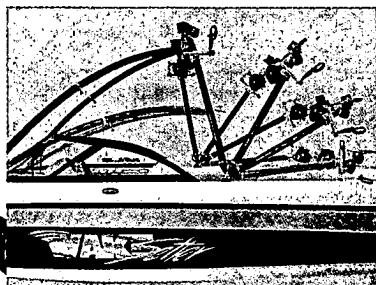
Subscribed and sworn to before me
this 12th day of February, 2001

Herbert L. Allen
Notary Public
My commission expires:



Personally known to me ✓
Produced identification of: _____

Gear Guide 2001

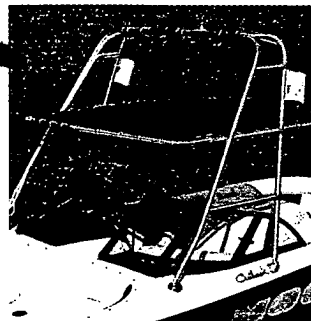


TITAN

Tower

MSRP: \$1,695 (plus installation)

Manf. Description: The Titan Tower is made from 2.25" stainless-steel tubing, providing exceptional corrosion resistance and incredible strength-to-weight ratio. Its two-piece design allows for quick and simple collapse for storage, yet its stainless steel construction and unique fastening system keep it rock solid and rattle free. The base plates and tow spool are CNC machined and polished aluminum.

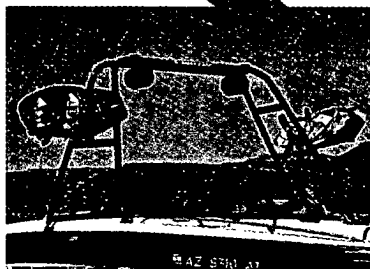


TODD'S T TOPS

Tower

MSRP: Call 407-644-3138

Manf. Description: Todd's towers are anodized, polished 6061 T6 aluminum. They are all custom built to fit any style of boat, even I/Os. For an additional cost, powder coating is also available if different colors are desired. Towers licensed under U.S. patent # 5,979,350.



WAKE DESIGNS

The Wake Cage

MSRP: \$1,600, \$1,800, \$2,250

Manf. Description: Made from 6061 T6 aircraft aluminum. Standard features include swivel tow eye, flag holder and mounting hardware. The Wake Cage is available in three styles: Sport Series (cage only), Pro Series (includes two board racks with welded mounts) and Super Pro Series (includes two board racks and Tubby speaker system with welded mounts).



WAKE DESIGNS

The Big Pole

MSRP: \$329, \$389

Manf. Description: The Big Pole features a swivel tow eye that increases the life of your rope. It comes with a stout bow sling and ratchet system rated at 3,200 pounds. Available in a one-piece, seven-foot design or a two-piece design that is adjustable from 6 1/2 to 8 1/2 feet.

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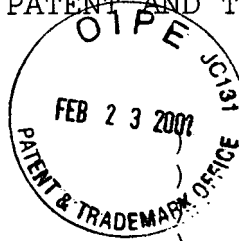
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



In re Reissue Application of:

BORDEN M. LARSON, ET AL.

Reissue of: U.S. Patent No. 5,979,350

Reissue Appln. No.: 09/613,154

Filed: June 30, 2000

For: WATER SPORT TOWING
APPARATUS AND METHOD

) Examiner:

) Mr. Stephen Avila

) Group Art Unit: 3617

) Current Status: Pending

Box REISSUE
Commissioner for Patents
Washington, D.C. 20231

AFFIDAVIT OF JAMES L. SMITH

State of Florida :
: ss
County of Brevard :

I, **JAMES L. SMITH**, having first appeared before the undersigned officer who is duly authorized to administer oaths in the State of Florida did depose and say:

1. I am the President of Batech, Inc., a Florida corporation whose address is 760 Mullet Drive, Port Canaveral, Florida 32920. I make this affidavit based upon my personal knowledge.

2. I have been actively involved in the welding trade here in Brevard County and the Cape Canaveral area continuously for the past 30 years. Batech, Inc. was incorporated in 1972 and does business under the trade name "Sunshine Welding". My company has, over the years, fabricated a wide variety of aluminum and steel hardware for the marine industry, including radar arches, T-tops, marlin towers, tuna towers, and similar structures. Sunshine Welding also manufactures items and products for various companies and organizations many of which are and have been certified by U.S. Coast Guard, the Department of Transportation, the U.S. Armed Forces, and various companies at Kennedy Space Center.

3. Since 1997, Sunshine Welding has fabricated towing towers for recreational towboats made by Correct Craft, Inc. of Orlando. We are presently fabricating an average of about 20 towing towers per week for Correct Craft.

4. Correct Craft first brought its towing tower design to Sunshine Welding in 1997. Prior to that time, I had not seen a towing tower structure designed for the specific purpose of providing a more stable tow for skiers and wakeboarders being pulled behind a recreational towboat.

5. I have been provided with a good color copy of the cover, page 4 and page 92 of the September 1995 issue of *Powerboat* magazine. I have also had an opportunity to see an original copy of that issue of *Powerboat* magazine. Additionally, I have been provided with copies of the October 26, 2000 declaration of Mr. Ron Schmitt, and United States Patent 5,979,350.

6. I have carefully reviewed the materials listed in ¶5 above. It is my considered opinion that the opinion expressed by Mr. Schmitt in his declaration is incorrect. The reasons why I believe Mr. Schmitt's declaration is incorrect are discussed in detail in ¶7-10 below.

7. Even a careful scrutiny of the upper photograph on page 4 of the September, 1995 issue of *Powerboat* magazine does not reveal several key features of the Correct Craft design. Features in the Correct Craft design which cannot be discerned from this photograph include: (a) the construction details of the tower, (b) how the tower structure is attached to the hull, (c) whether the tow rope is centrally attached to a horizontal bridging member, (d) the relationship of the tower structure to


the operator position, and (e) the relationship of the tower structure to the lateral and side windshield portions.

8. I have also read the text at pages 4 and 92 which are associated with this photograph. This text does not provide any further disclosure of the tower construction which is shown in that photograph.

9. I also note that the boat shown in this photograph appears to be a fishing hull (i.e., having a V-bottom). The combination of a photo tower on a fishing hull would not reasonably lead me to conclude that the photograph suggests a towing tower useful with recreational towboats for skiers and wakeboarders.

10. In summary, it is my opinion that the photograph and article at pages 4 and 92 of the September, 1995 issue of *Powerboat* magazine would not reasonably lead me to the specific towing tower construction disclosed in U.S. Patent 5,979,350 without the benefit of a hindsight analysis using the patent as a guide.

FURTHER AFFIANT SAYETH NOT.


JAMES L. SMITH

Subscribed and sworn to before me
this 14th day of FEB, 2001

Stanley D. Kammerude

Notary Public

My commission expires: Sept 8th 2002

✓ Personally known to me

Produced identification of:

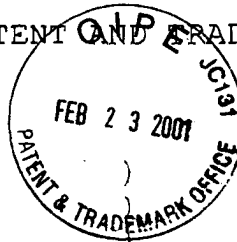


Stanley D. Kammerude
Commission # CC 761915
Expires Sep. 8, 2002
BONDED THRU
ATLANTIC BONDING CO., INC.



7

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



In re Reissue Application of:

BORDEN M. LARSON, ET AL.

Reissue of: U.S. Patent No. 5,979,350

Reissue Appln. No.: 09/613,154

Filed: June 30, 2000

For: WATER SPORT TOWING
APPARATUS AND METHOD) Examiner:
) Mr. Stephen Avila
) Group Art Unit: 3617
)
) Current Status: Pending
)
)
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)Box REISSUE
Commissioner for Patents
Washington, D.C. 20231**DECLARATION OF CARLOS A. RIVERO****CARLOS A. RIVERO** declares that:

1. My permanent residence is in Orlando, Florida. I am presently a pre-med student at Tulane University in New Orleans.

2. I took up the sport of wakeboarding in 1995. At that time, the only equipment available for providing an elevated tow rope attachment point were elevated pylons. However, boats having elevated pylons tended to be unstable during use.

3. Between 1995 and 1998, I competed in a number of wakeboarding competitions, and in 1998 won the Junior National Championship. At a time I do not specifically recall but which was in 1997 or 1998, Correct Craft came out with its towing tower. I had the opportunity to perform wakeboarding tricks while being towed behind a Correct Craft NAUTIQUE tow boat fitted with one of these new towing towers. I found the towing tower to be a significant improvement over extended pylons.

4. At no time prior to its introduction did I ever see a towing tower construction like that of Correct Craft.

5. I affirm that the statements made above are true, and that I understand that there are penalties for making false statements.

SIGNED ON THIS 15 day of February, 2001.


CARLOS A. RIVERO

A circular black and white stamp from the OIPF Patent & Trademark Office. The text "OIPF" is at the top, "PATENT & TRADEMARK OFFICE" is around the bottom, and "FEB 23 2001" is in the center.

BORDEN M. LARSON, ET AL.

Examiner:
Mr. Stephen Avila
Group Art Unit: 3617

Current Status: Pending

For: WATER SPORT TOWING
APPARATUS AND METHOD

AFFIDAVIT OF DEAN LAVELLE

1. I have resided in Florida since 1984. I am a former professional athlete on the waterskiing and wakeboarding tours. I am presently self-employed as an instructor under the business name Lavelle Train Station. This Affidavit is based upon my personal knowledge.

2. Because of a temperate climate and numerous lakes, recreational water sports (such as water skiing, knee boarding and wakeboarding) flourish in the Central Florida area. I have been involved as a professional athlete in recreational water sports for eleven years, and since 1992, have been actively involved in the sport of wakeboarding in Central Florida.

3. In the wakeboarding sport, the athlete is pulled by a towrope behind a boat and attempts various tricks. Some of these tricks require the athlete to jump as high as possible (these are sometimes referred to as "aerial tricks"). The athlete's ability to perform these aerial tricks is enhanced if the attachment point of the towrope is elevated to a height substantially greater than the deck and sides of the boat. Thus, the wakeboarding sport has always had a need for an elevated towrope attachment point.

4. Prior to 1997, this need for an elevated attachment point was being met with the use of extended pylons that attach at a central location to the floor of the boat.

5. In the fall of 1996, Correct Craft, Inc. requested that I experimentally evaluate its new wakeboard towing tower. This was done in two phases. First, with Correct Craft personnel on Lake Jessamine. Correct Craft then delivered a boat with a mounted tower to my home at Lake Sawyer here in the Orlando area. I was towed behind this boat while performing various wakeboarding tricks

in order to evaluate this tower design. I found that Correct Craft's new wakeboard tower design dramatically improved the stability of the boat and thus the performance of wakeboarding tricks when compared to elevated pylons.

6. I am very familiar with the "Hit It" performance video being marketed by FLF Films, Inc.; in fact, I am one of the wakeboarding athletes depicted in that video. That portion of the video in which I am performing was taken on the Conway chain of lakes and in the Florida Keys. The wakeboarding tricks that I performed for that video were not carried out in a public setting.

7. During the shooting of the "Hit It" video, I was being towed behind a fishing boat fitted with a photography tower. I suggested to the photographer that the towrope be attached to the photography tower. However, only a fleeting glimpse of that attachment is depicted in the video.


8. The photography tower used for the shooting of the "Hit It" video is attached to the bottom of the boat rearwardly of the operator station.

9. I also found that the Correct Craft tower described in ¶5 was substantially more stable and gave a much more consistent pull than the photo boat used in the "Hit It" video.

FURTHER AFFIANT SAYETH NOT.

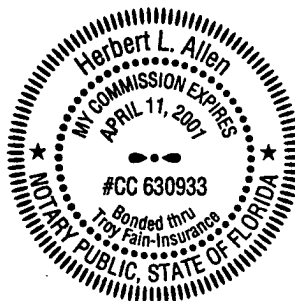

DEAN LAVELLE

Subscribed and sworn to before me
this 9th day of February, 2001

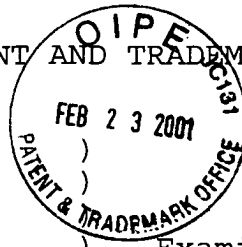

Notary Public
My commission expires:

Personally known to me ✓

Produced identification of:



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



In re Reissue Application of:

BORDEN M. LARSON, ET AL.

Reissue of: U.S. Patent No. 5,979,350)

Reissue Appln. No.: 09/613,154)

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APPARATUS AND METHOD)

Examiner:

Mr. Stephen Avila

Group Art Unit: 3617

Current Status: Pending

Box REISSUE

Commissioner for Patents

Washington, D.C. 20231

AFFIDAVIT OF WILLIAM N. SNOOK

State of Florida :
: ss
County of Orange :

I, **WILLIAM N. SNOOK**, having first appeared before the undersigned officer who is duly authorized to administer oaths in the State of Florida did depose and say:

1. I am one of inventors in the above identified matter. I am fifty years of age and make this Affidavit based upon my personal knowledge.

2. I have resided in Orlando, Florida continuously since September, 1983. For the last seventeen years, I have been

employed at Correct Craft, Inc. of Orlando, Florida, and for at least the past ten years I have been the Manager of Engineering at Correct Craft. I received a Bachelors Degree in mechanical engineering from Pennsylvania State University in 1973.

3. As engineering manager at Correct Craft, I oversee the conception, design and development for a large variety of projects, ranging from towboat hull designs to accessory equipment designs, such as the towing tower and methods for towboats which are the subject of the identified patent.

4. Prior to the development of the towing tower which is the subject of the '350 patent, the recreational towboat industry was using extended pylons to elevate the tow rope attachment point, even though extended pylons present the following possible problems: (a) overstress of the pylon, the pylon attachment point and any supporting structure; (b) an adverse effect on towboat handling; (c) the intrusive effect of pylon equipment into the occupied spaces of the towboat; and (d) the inconvenience in setting up and storing pylons.

5. The events surrounding the conception and first reduction to practice of the towing tower for towboats disclosed in the '350 patent during 1996 are described in the affidavits of Borden M. Larson, Robert Todd and myself filed earlier in the re-issue application. During the building of the first tower (and

even later with production models), we were very concerned about the effect upon the towing tower, the tower leg attachment points and the towboat caused by the substantial horizontal forces exerted by the towrope, and also the effect that changing directions of that force caused by movement of the athlete being towed might have. Our concerns in this regard were made more complex by the fact that many towboat hull designs have non-planar and/or non-horizontal surfaces at the location where the tower attachment points would be made.

6. Our initial design for a towing tower employed four legs and two upper horizontal bridging portions, as is shown by the original concept shown in Figs. 9 and 11-13 in the '350 patent. One of the key features of this design was the attaching of the tow rope connecting element with one of the horizontal bridging portions, in order to spread the rearward towing forces along that horizontal bridging portion, along the vertical stanchions and also to the second, connected horizontal bridge and vertical stanchions through attached horizontally-welded bars. This specific construction is depicted in the drawings of U.S. Design Patent 409,972 (Exhibit B) and U.S. Patent 5,979,350 (Exhibit C); this construction is also specifically recited in Claims 35-36 of the '350 patent. The feature of "attaching a tow rope to the horizontally extending bridging portion" is specifically recited in Claim 1 of the '350 patent.

7. With the design features discussed above in mind, the construction of the first prototype was carefully monitored during the testing by professional athlete Dean Lavelle, described in his accompanying affidavit. Further, Correct Craft continued to monitor the construction of later production models of the towing towers, in order to be satisfied that these tower structures met acceptable criteria for tower and attachment point strength and durability, and overall stability when mounted on a recreational towboat.

8. During the course of my activities as engineering manager (and as an engineer prior to assuming that position), I frequently am required to conduct testing operations on various product designs being developed at Correct Craft. Those testing operations usually involve using on the water a towboat having the design feature incorporated in, or mounted on, the towboat being tested under rigorous towing conditions. I have conducted or monitored such testing and/or evaluation operations in the following lakes in the Central Florida area since 1990: Lake Conway; Lake Jessamine; Lake Ivanhoe; Lake Hancock; Lake Pickett; Lake Sheen; Pocket Lake and other lakes on the Butler chain of lakes; Lake Lotus; Lake Fairview; Lake "X"; Lake Hart; Lake Mary Jane; some of the lakes in the Winter Park and Winter Haven chains; and numerous other lakes. Also in connection with my responsibilities first as an engineer and later as engineering manager of Correct Craft, I quite frequently attend boat shows,

trade exhibitions and the like where new products and new ideas are on display. I conservatively estimate that since 1990, I have attended approximately forty such events in the United States and in foreign countries.

9. At no time prior to 1997 while engaging in the activities described in ¶¶8 above did I ever observe a towing tower useful with recreational towboats remotely similar to that which we designed in the Fall of 1996.

10. I have carefully reviewed the materials submitted with the Protest filed by our competitor, MasterCraft Boat Company, and submit the statements set out at ¶¶11-16 below in opposition to the Protestor's suggestions that the claims in the '350 patent are somehow rendered unpatentable in view of (a) the minuscule photograph appearing at page 4 of the September 1995 issue of *Powerboat* magazine; (b) the "Hit It" video; (c) the Declaration of Tom King and the unverified letter of David Reinhart; and (d) the Schmitt Declaration.

11. The minuscule photograph at page 4 of the September 1995 issue of *Powerboat* magazine discloses a photo tower mounted on that magazine's broad-beamed Nordic 23-foot V-bottom fishing boat. (I never saw this photography prior to the Protest; I have also checked with Borden Larson, another of the inventors, and

learned that he did not see this photograph prior to the Protest.) The details of the photo tower construction cannot be determined from the photograph nor from the accompanying article. Even after reviewing both the enlarged version of the photograph which MasterCraft attached to its Protest at Tab 1 and recently, an original copy of this magazine, I cannot see any relationship between that photo tower and the towing tower construction of our invention. This minuscule photograph and the accompanying article are totally insufficient to enable anyone skilled in the field to understand how to construct a production model of a towing tower for a towboat, and having a tow rope connecting element attached to a horizontally extending member so as to meet the technical criteria which I have discussed in ¶¶5 and 6 above. Further, the fact that no recreational towboat manufacturer came out with a production towing tower for use on towboats suitable for towing wakeboarders until more than two years after this article is a clear indication that it did not teach anyone skilled in this field how to design such a towing tower.

12. During the summer of 1998 or 1999, Correct Craft was invited by *Powerboat* magazine to participate in a test of wakeboarding towboats on Lake Mohave, along the Colorado River. In order to have a boat at that test, I flew to Phoenix, Arizona and picked up a Correct Craft **NAUTIQUE** towboat from our Arizona dealer, Century Marine. A towing tower essentially identical to

that shown in both the '972 design patent and at Figures 1, 2 and 5-10 of the '350 patent was mounted on this towboat. I then trailered that boat to Lake Mohave, and observed *Powerboat* magazine's tests over a period of two days. During that time, the magazine's photographer took photographs of the test from a photo tower mounted on a 23-foot Nordic fishing boat having a V-shaped hull. I believe this photo boat to be the same boat shown at page 4 of the September 1995 issue of *Powerboat* magazine. At no time did I witness a wakeboarder or skier being towed behind this boat. On one of the days of the test, I was invited to ride on this Nordic photo boat. Although I was at the test with a **NAUTIQUE** towboat having a wakeboard towing tower (which was photographed by the same photographer on the magazine's Nordic), at no time did the photographer make any statement in my presence that the technique of being towed from Correct Craft's proprietary towing tower was in any way similar to the magazine's prior activities.

13. The "Hit It" video also does not contain a clear, enabling disclosure of a towing tower construction which meets the technical design criteria as discussed above in ¶¶5 and 6, so as to meet acceptable structural performance, safety and aesthetic requirements. In fact this video contains dozens of scenes of towboats with extended pylons; the two brief scenes near the end of the video showing a tow rope attached to a

photography tower mounted on a fishing hull do not clearly show construction details or how the tow rope attachment point is coupled to the tower.

14. The King declaration and the Reinhart letter suggest that Mr. King and Mr. Reinhart were the inventors of this concept first in 1991, again in 1992, and that their activities were witnessed publicly. Given the significant improvement that a towing tower creates over extended pylons--as is recognized by the uniform adoption by all towboat manufacturers of towing towers in lieu of extended pylons--it is highly likely that Mr. King's invention (if in fact it was made public), would have caught on dramatically among wakeboard enthusiasts here in Central Florida. With its many lakes, Central Florida is a "hotbed" of wakeboarding activity. Mr. King's alleged invention could not have been public without having come to the attention of these enthusiasts, with a concomitant development of towing tower equipment manufactured by local welding shops, or even by the wakeboarding enthusiasts themselves. Yet in the 1991-1996 period, I did not see a single towing tower anywhere (including in Central Florida) which emulates either that of Mr. King's design as shown in his Declaration, or that of the Correct Craft design. However, during that same period, extended pylons of greater heights were being made and used in an effort to raise the towrope attachment point. For these reasons, it is clear to me that Mr. King's activities were not truly "public".

15. Even if Mr. King's activities described in his declaration were conducted publicly, those activities would not meet the particular methods and construction features recited in Claims 1-49, inclusive, of the '350 patent. For example, Claim 1 recites the step of "attaching a rope to the horizontally extending bridging portion"; in contrast, the photograph attached to

Mr.
King's declaration shown the tow rope attached to a thin, vertically extending flat plate which appears to be welded at the top to the edge of a platform and at the bottom to a truss fabricated from a small gauge aluminum tubing. This thin plate does not, in my opinion, provide a safe and durable construction which would withstand the rearward forces of a towed athlete performing wakeboarding tricks over a substantial period of time.

16. I have also reviewed the Declaration of Ron Schmitt, the President of G.G. Schmitt & Sons, Inc. I disagree entirely with the opinion stated by Mr. Schmitt at ¶9 of his Declaration. The very minuscule photograph in the September, 1995 issue of *Powerboat* magazine and the accompanying non-technical discussion regarding the photo tower mounted to a 23-foot Nordic photo boat does not in any way assist a skilled worker in understanding how to resolve the various technical concerns addressed in ¶¶5 and 6 above, without substantial experimentation.

FURTHER AFFIANT SAYETH NOT.

WN Snook

WILLIAM N. SNOOK

Subscribed and sworn to before me
this 15th day of February, 2001

Angela R. Pilkington

Notary Public

My commission expires:



ANGELA R. PILKINGTON
My Comm Exp. 5/16/2001

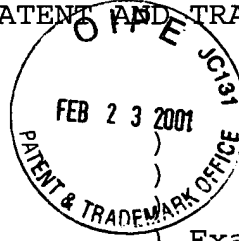
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Personally known to me

Produced identification of: _____

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



In re Reissue Application of:

BORDEN M. LARSON, ET AL.

Reissue of: U.S. Patent No. 5,979,350

Reissue Appln. No.: 09/613,154

Filed: June 30, 2000

For: WATER SPORT TOWING
APPARATUS AND METHOD

) Examiner:

) Mr. Stephen Avila

) Group Art Unit: 3617

) Current Status: Pending

Box REISSUE
Commissioner for Patents
Washington, D.C. 20231

AFFIDAVIT OF LAWRENCE J. MEDDOCK

State of Florida :
: ss
County of Orange :

I, **LAWRENCE J. MEDDOCK**, having first appeared before the undersigned officer who is duly authorized to administer oaths in the State of Florida did depose and say:

1. I have resided in Orlando, Florida continuously since 1978. I am employed as the Vice-President for Marketing and Special Events at Correct Craft, Inc. of Orlando, Florida, and make this Affidavit based upon my personal knowledge.

2. Correct Craft is the oldest continuous manufacturer of inboard boats specifically designed for use with recreational water sports, especially as towboats for skiing, knee boarding and wakeboarding sports. I am responsible for keeping close track of new developments in these recreational water sports, and I am particularly responsible for evaluating the safety, technical and marketing merits of new equipment and product developments.

3. Prior to 1997, there had been developed a line of extended pylons used in recreational water sports, especially for wakeboarding, in order to elevate the tow rope attachment point. Examples of extended pylons are depicted in the following pages of the December, 1997 issue of *Wake Boarding* magazine, attached as Exhibit A: 11 (Malibu), 16 (Wake Designs ad), 24, 27 (MasterCraft ad), 56, 67, 75, 84, 92, 93 (Skylon ad), and 103 (unnumbered page with Air Boom ad). Because extended pylons create instability and have risk attributes, prior to 1997 Correct Craft refused to mount extended pylons on its towboats as original equipment for production models. However, manufacturers of extended pylons advertised their products for installation on our boats, as shown by the Wake Design and Air Boom advertisements at pages 16 and 103 of Exhibit A.

4. In 1997, Correct Craft introduced a new towing tower design which is fitted across the beam of the towboat above the operator, with four spaced legs fixed to the sides of the boat

and a horizontal bridging portion above the operator to which the tow rope is attached. This towing tower is specifically designed to transmit rearward horizontal forces from a skier or wakeboarder being towed from the attachment point at the top of the tower to the gunwales of the towboat both forward and aft of (or adjacent to) the operator's position. Correct Craft's new towing tower was initially met with considerable derision and skepticism by competitors when it was first introduced. Since then, however, every boat manufacturer which sells inboard towboats in competition with Correct Craft has copied our tower designs, as have a number of secondary market equipment manufacturers. This is evident from a comparison of the December, 1997 issue of *Wake Boarding* magazine, Exhibit A, with the February 2001 issue of *Wake Boarding* magazine attached as Exhibit B. *Wake Boarding* magazine is published by World Publications, Inc. which is headquartered in Orlando; in addition to this magazine World Publications also publishes *WaterSki* magazine and *Boating Life* magazine.

5. The following is a guide to the advertisements for towing towers in Exhibit B:

<u>Manufacturer</u>	<u>Page in Exhibit B</u>
Air Boom	101
Atlantic Towers	101
Big Air	101
Boss Accessories	101

Calabria	93
Centurion	93
Correct Craft	93
Eyeful Towers	101
Gekko	93
Ichor	102
Infinity	94
Joystick	103
Malibu	94
MasterCraft	95
MB	95
Moomba	94
Proflight	102
Phat Budde	103
Sanger	94
Skylon	94
Supra	95
Ski Supreme	95
Ten Foot Pole	103
Tige	96
Todd's T-Tops	104
Toyota	96
Wake Designs	104

6. As can be seen from the pages of Exhibit A referred to in ¶13, extended pylons were being used exclusively with towboats in 1997, despite the instability and risks associated with that equipment. In contrast, by 2001, almost all towboat and add-on equipment manufacturers had discontinued offering extended pylons and were primarily offering towing tower equipment which emulates Correct Craft's design.

7. During November, 2000, I and other Correct Craft officers together with Correct Craft's attorney met with officers and the attorney for MasterCraft, one of Correct Craft's competitors. During that meeting, MasterCraft's representatives requested a license under Correct Craft's tower patent, U.S. Patent 5,979,350 on extremely favorable terms and conditions, and stated that if its terms were not met, then MasterCraft would file a protest in Correct Craft's pending reissue application. Correct Craft refused MasterCraft's demand, and the presently pending protest was filed by MasterCraft's attorney. (At that meeting we did, however, offer MasterCraft a license on the same terms as given to Correct Craft's existing licensees.) I have had an opportunity to carefully review the protest, and provide facts relevant to the protest as outlined in ¶8-18 below.

8. I have reviewed the minuscule photograph shown on page 4 of the September, 1995 issue of *Powerboat* magazine set out at Exhibit 1 to the protest. I have also read carefully the letter from publisher Jerry Nordskog on page 4 and continued on page 92. From that review, I have learned that the "trick" described in the article was done while being towed behind a boat fitted with a photo tower. However, the details of the photo tower are not described in the article or shown in the photograph, particularly as to the manner in which the tow rope is attached, how the vertical legs are mounted to the boat or the

relationship of the tower to the operator position and the windshield. This small photograph and the brief description would simply not enable one of ordinary skill in the design of equipment in the recreational boating industry to understand how a towing tower usable with conventional inboard towboats could be constructed without considerable experimentation.

9. I have also carefully reviewed the entire "Hit It" video, which is the subject of the excerpts at Tab 2 of MasterCraft's protest. The "Hit It" video contains dozens of scenes showing towboats using extended pylons. Near the end of the video there are two brief scenes showing a tow rope attached to a photo tower mounted on a fishing boat. The manner in which the tow rope is attached to the tower is not disclosed. This brief disclosure is totally insufficient to enable one of ordinary skill in the art of designing equipment for inboard towboats to understand how to develop a workable towing tower, without a significant level of experimentation.

10. I have also carefully read the Declaration of Tom King at Tab 5 of the protest, and the letter of David Reinhart at Exhibit 6. Tom King is a professional photographer that does a substantial amount of work for our competitor, MasterCraft. I believe that Mr. King's declaration is inaccurate for the reasons set out in ¶¶ 11-16 below.

11. I am very familiar with the facilities at the Orange County Sportsmen Association on Lake Sheen, and am also aware that the Sportsmen Association's facilities are not open to the public. Therefore, to the extent that the individuals described in paragraph 3 of Mr. King's Declaration were in fact present, those individuals could not have been members of the general public.

12. Lake Sheen is not a publicly accessible lake, except by passage through several canals from Lake Down, several lakes away. It is extremely unlikely that members of the public were in fact watching the purported events described by Mr. King.

13. It is also unlikely that employees of *Waterski* magazine witnessed the events described in Mr. King's Declaration in a public manner, because *Waterski* magazine did not later publicize those events. World Publications, the publisher of *Waterski* magazine, did later publish a report in the January/February 2001 issue of *Boating Life* magazine (another of its boating publications) acknowledging Correct Craft's innovation with respect to towing towers; a copy of the relevant portions of this issue of *Boating Life* containing this article at page 23 is appended as Exhibit C.

14. I have known Tom King for many years, and am also familiar with David Reinhart, who has contracted in the past

both with MasterCraft and Correct Craft as a professional athlete. Based upon my experience with Mr. King, I believe that it is extremely doubtful that he would permit any of his photography sessions to be conducted in public. In fact, it is my experience that Mr. King is careful to not conduct his photographing sessions in public, so that the photographs he does for MasterCraft and other publications are not "scooped" by amateur photographers. It is therefore particularly noteworthy that Mr. Reinhart's undated letter at Tab 6 of the protest addressed to MasterCraft's President makes no reference to members of the public or the media being present.

15. I have also reviewed the assertions in ¶5 of Mr. King's Declaration. I would first note that Lake Tibet-Butler is a rather large lake with very limited public access; there are substantial portions of this lake that are not viewable from any public vantage point. As I stated above, it is extremely unlikely that Mr. King would conduct his photo shoot in a location in public view, to avoid having the shoot being "scooped" by an amateur photographer. It is also noteworthy that the Reinhart letter makes no mention at all of this 1992 activity referenced at ¶5 of the King Declaration.

16. Our competitor MasterCraft has been one of the most aggressive copiers of Correct Craft's towing tower designs. If its freelance photographer, Mr. King, had satisfactorily achieved an elevated towing tower as early as 1991-92, then it

is highly likely that Mr. King would have passed that information along to the officers and engineers at MasterCraft. The fact that MasterCraft did not begin marketing towing towers until well after Correct Craft introduced those products in the spring of 1997 clearly demonstrates that the alleged 1991-1992 activities of Mr. King and Mr. Reinhart were not "public". This is bolstered by the fact that I have resided in the Central Florida area for the past twenty-two years and have been intimately involved in the recreational water sports industry during that time. Yet, I have never heard a single word about Mr. King's alleged developments regarding elevated towing points on his photography tower. Had they indeed been "public" as Mr. King suggests, I am convinced that I would have heard of that. In fact, however, the first suggestion I ever heard regarding a proposed towing tower was that made by the inventors in U.S. Patent 5,979,350 at a confidential strategy session at Correct Craft in the fall of 1996. When I first heard that suggestion, I was extremely skeptical as to whether that towing tower design was feasible, and I had to be convinced of its merits.

17. Since the Correct Craft towing tower design was introduced in the spring of 1997, not only are new towboats now being fitted with towers emulating Correct Craft's design, there has developed a substantial retrofit market for such towing towers to be mounted on boats already in service. This can be seen from the advertisements in the magazine of Exhibit B for retrofit towers at the following pages: 101 (Air Boom, Atlantic

Towers, Big Air, Boss Eyeful and GX2); 102 (Ichor, Phat Budde, Skylon and Ten Foot Pole); 103 (Joystick and Proflight); and 104 (Titan, Todd's T-Tops and Wake Designs).

18. At page 17 of its Protest, MasterCraft argues that any copying of Correct Craft's towing tower design is because of "a lack of concern that the '350 patent is valid, rather than a lack of independent technical know-how." MasterCraft's argument is deceptive for two reasons. First, some boat and equipment manufacturers have in fact informed Correct Craft that they are willing to pay royalties for a license under the Correct Craft patents, despite MasterCraft's challenge. Second: those manufacturers with whom Correct Craft representatives have spoken and who are presently declining to pay licensing royalties have indicated they are taking this position because representatives of MasterCraft have contacted them, giving assurances that MasterCraft "is going to win the Protest and destroy Correct Craft's patent," or words to that same effect. Further, contrary to MasterCraft's inaccurate representations at the bottom of page 17 of the Protest regarding the size of the companies willing to take a license, Correct Craft is discussing a licensing arrangement with U.S. Marine/Bayliner and Regal Boats, both of whom are significantly larger than MasterCraft.

19. As noted above, there were no known towing towers for towboats available prior to the introduction by Correct Craft in the Spring of 1997 despite a real need for safer equipment to replace extended pylons.

FURTHER AFFIANT SAYETH NOT.


LAWRENCE J. MEDDOCK

Subscribed and sworn to before me
this 15th day of February, 2001


Notary Public

My commission expires:

Personally known to me ☒

Produced identification of:



DECLARATION OF RON SCHMITT

I, Ron Schmitt, having an address of 7230 15th Street East, Sarasota, Florida 34243, declare the truth of the following statements:

1. I am the President of G.G. Schmitt & Sons Inc., a manufacturer of marine hardware for pleasure boats, including ski boats. Since 1951, G.G. Schmitt & Sons Inc. has manufactured and sold thousands of boat-mounted aluminum structures, including photo towers, observation towers, arches, and T-tops.

2. I have a Bachelor of Science degree in Industrial Management. I have designed marine hardware for G.G. Schmitt & Sons Inc. since 1971.

3. Having worked as a designer in the marine hardware industry for almost 30 years, I am knowledgeable about the level of ordinary skill in that industry for the years 1995 through 1998.

4. I have read U.S. Patent No. 5,979,350 ("the '350 patent"), issued to Correct Craft, Inc. and entitled "Water Sport Towing Apparatus And Method," and have an understanding of the subject matter covered by the claims of that patent. I have been informed that the filing date of the application for the '350 patent was March 9, 1998, and that the '350 patent is the subject of a pending reissue proceeding.

5. I am familiar with Correct Craft, Inc., which has purchased accessories other than wakeboard towers from G.G. Schmitt & Sons Inc. in the past. I have never been contacted by Correct Craft, Inc. in regard to the '350 patent. The first time I saw the '350 patent was in connection with the preparation of this Declaration.

6. G.G. Schmitt & Sons Inc. does not currently make or sell towers

specifically intended for towing a water sports performer, nor has it done so in the past. But in the interest of full disclosure, G.G. Schmitt & Sons Inc. is contemplating, at the request of some of its customers, the possibility of making wakeboard towers.

7. I am familiar with an article in a September 1995 issue of *Powerboat* magazine (pages 4 and 92), describing and illustrating the use of a tower-equipped boat to tow a trick skier sitting on an “Air Chair” (“the *Powerboat* article”).

8. I find that the *Powerboat* article discloses all of the features recited in claims 12, 15, 16, 18, 19, 22, 24-27, 29, 30, 33, 35, 36, 38, and 39 of the ‘350 patent.

9. In my opinion, during the time period from September 1995 to March 1998, an ordinarily-skilled marine hardware designer could have built a tower for towing a water sports performer and mounted such tower amidships on a boat, as recited in claims 12, 15, 16, 18, 19, 22, 24-27, 29, 30, 33, 35, 36, 38, and 39 of the ‘350 patent, based solely on the disclosure of the *Powerboat* article in combination with his or her own knowledge and skill, and without reference to the teachings of the ‘350 patent. Given the clear teaching of the *Powerboat* article to mount a tower amidships for the purpose of towing a water sports performer, the design, manufacture, and installation of such a tower would have been routine mechanical tasks, easily within the level of ordinary skill in the marine hardware industry during that time period.

10. In my opinion, an ordinarily-skilled marine hardware designer would have recognized that the tower could be attached either to the raised gunwales of the boat, as appears to be shown in the *Powerboat* article, or to the floor of the boat, depending on the configuration of the boat. Provided the gunwales of the boat were of sufficient structural integrity to withstand the load resulting from attaching the tower thereto, the ordinarily-skilled marine hardware designer would have, in my opinion, preferred to attach the tower to the gunwales. In that way,

the interior of the boat would remain relatively unobstructed, thus facilitating the free movement of the driver and passengers around the boat..

11. Throughout the time period from September 1995 to March 1998, it was widely recognized in the marine hardware industry that boats frequently need to pass underneath bridges or into boat houses. Accordingly, boat-mounted structures that protruded substantially above the boat often were hinged at their base, using commercially-available hinged tower fittings such as shown, for example, on page 34 of a 1987 Taco Supply Marine Catalog. In that way, the structures could be rotated downward whenever it was necessary for the boat to pass under a low clearance.

12. Prior to March 9, 1997, G.G. Schmitt & Sons Inc. had designed and sold many photo towers, observation towers, and T-tops that were made to hinge at their base for passage underneath low clearances and storage purposes. These structures were mounted amidships on a boat at a location above the operator station.

13. I hereby affirm that all statements made on the basis of my own knowledge are true and that all statements made on information and belief are believed to be true. I understand that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001.

EXECUTED ON THIS 26 DAY OF OCTOBER, 2000.

A handwritten signature in black ink, appearing to read "Ron Schmitt", written over a horizontal line.

Ron Schmitt